Supreme Court, U. S.
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Supreme Court of the United States

October Term, 1977

No. 77-1710

NATIONAL WILDLIFE ART EXCHANGE, INC.,
AND RALPH H. STEWART,
Petitioners,

vs.

FRANKLIN MINT CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Third Circuit

WILLIAM C. McCOY, JR.
BOSWORTH, SESSIONS & McCOY
625 National City Bank Building
Cleveland, Ohio 44114
Counsel for Petitioners

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-5647

TABLE OF CONTENTS

Table of Authorities II
Opinions Below 1
Jurisdiction 2
Questions Presented for Review 2
Statutes Involved 2
Statement of the Case 3
Reasons for Granting the Writ 7
The Writ Should Be Granted 9
Appendix:

- Judgment Entry of the Court of Appeals for the Third Circuit (April 17, 1978) A1
- Opinion of the Court of Appeals for the Third Circuit (April 17, 1978) A3
- Memorandum Opinion of the District Court (March 15, 1977) A14

Exhibits—

- First painting "Cardinals on Apple Blossom" A37
- Second painting "The Cardinal" A38
- Franklin Mint Exhibit 83F—Compositional sketch for first painting used in making second painting A39
- National Wildlife Exhibit 97—Closest cardinal painting by other artist A40
- Negatives of first and second painting ..... In pocket on inside back cover

TABLE OF AUTHORITIES

Cases

Graham v. John Deere, 383 U.S. 1 (1966) 9
Gross v. Seligman, 212 Fed. 930 (2nd Cir. 1914) 8
Nichols v. Universal Pictures Corporation, 45 F.2d 119 (2nd Cir. 1930) 8
Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977) 8
Washington Publishing Co. v. Pearson, 306 U.S. 30 (1939) 7

Statutes

17 U.S.C. Sec. 101 2
17 U.S.C. Sec. 501 3

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PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Third Circuit

National Wildlife Art Exchange, Inc. and Ralph H. Stewart, petitioners herein, respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit entered on April 17, 1978, affirming the judgment of the United States District Court for the Eastern District of Pennsylvania.

OPINIONS BELOW

The opinion of the District Court is reported at 195 United States Patents Quarterly 31 (E.D. Pa. 1977) and is reprinted in the appendix to this petition. The opinion of the Court of Appeals has not yet been reported and is also reprinted in the appendix to this petition.

JURISDICTION

The judgment of the United States Court of Appeals for the Third Circuit was entered on April 17, 1978. The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254(1).

QUESTIONS PRESENTED FOR REVIEW

(1) Can an artist closely duplicate his prior work and pass immunity from copyright infringement on to his publisher?

(2) Does the first publisher of limited edition prints have any enforceable copyrights against subsequent publishers when the closely duplicated prints are by the same artist?

(3) Does any publisher of a limited edition print have any enforceable copyrights against subsequent publishers when the closely duplicated limited editions are by other artists?

(4) Can the intent of Congress as expressed in the Copyright Statutes be vested in and to the sole discretion of artists whereby each artist/publisher has the sole responsibility for determining what infringes and what does not?

STATUTES INVOLVED

17 U.S.C. Sec. 101

Infringement.—If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person will be liable:

(a) Injunction.—To an injunction restraining such infringement;

(b) Damages and Profits; Amount; Other Remedies. —• • •

(1905 Act)

17 U.S.C. Sec. 501

Infringement of Copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by section 106 through 118 or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright.

(b) • • •

(1976 Act)

STATEMENT OF THE CASE

A wildlife artist by the name of Albert Earl Gilbert made a first painting of a male and female cardinal on a forked branch of an apple tree in blossom which is called "Cardinals on Apple Blossom".

National Wildlife published and distributed copies of that first painting in a limited edition print of 300 for which it charged $75. The artist was paid $1500 for the painting and all reproduction rights.

Approximately three years later, the same artist made a second painting of a male and female cardinal on a forked branch of an apple tree in blossom which is called "The Cardinal". Franklin Mint published and distributed

copies of that painting in an edition of at least 6,000 copies for which it charged $120.

The second painting was the last of a series of four bird paintings done by the artist per contract with Franklin Mint. The contract provided that the artist had to submit preliminary sketches of each painting for approval, which was done for the first three paintings. For "The Cardinal", Franklin Mint was shown only a print of National Wildlife's painting.

Franklin Mint had full knowledge of the artist's prior relationship with National Wildlife and of the fact that the first painting was a success and had gone to a premium in the resale market of at least $750.

Franklin Mint sold its reproductions by direct mail solicitation from small lithographic reproductions as did National Wildlife. Over one million full color brochures were mailed out by Franklin Mint and over 9.7 million full color inserts appeared in *National Geographic, Smithsonian, Audubon* and *Natural History* Magazines.

Both works are reproduced in the appendix to this petition.[1] The clerk of this Court has been provided with color photographs of the paintings which may be inspected, as desired.

The artist created the first painting by a technique wherein he made a compositional sketch of the two cardinals on the forked apple branch in pencil on white tracing paper and transferred that sketch to the board upon which

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1. Also inserted in an envelope in the back of this Petition are negative overlay photographs of the first cardinal painting (Cardinals on Apple Blossom) and the second cardinal painting (The Cardinal). The overlays are the same size as the Franklin Mint color brochure duplication of the second painting.

he made the painting. Pencil marks so transferred onto the board served as the guide and final outline for the painting. The artist admitted using this final compositional sketch for the second painting, such sketch being reproduced in the appendix. There was no comparable sketch for the second painting.

At the argument before the Court of Appeals, counsel for Franklin Mint admitted that if the second painting had been done by another artist, Franklin Mint "would have settled in a minute".

Except for the fact that the copyrighted and accused works were done by the same artist, National Wildlife should have prevailed. National Wildlife proved access and per the above statement Franklin Mint admitted substantial similarity.

It is inconceivable that one artist could have admitted using another artist's final compositional drawing in creating a painting, testified that he did not copy and that such testimony would have been given any weight. It is likewise hard to believe that the Court of Appeals would have drawn its fine "variation on a theme" line had another artist painted the second work.

The result is that a double standard has been established wherein artists will now be able to closely duplicate prior work and pass on immunity from copyright infringement to their publishers, to their mutual profit and to the considerable damage of the first publisher and to the limited edition print industry as a whole.

The District Court did not pass on the question of substantial similarity to an ordinary lay observer. The Court of Appeals acknowledged that there were indeed obvious similarities between the two works but that such

similarities concerned "the idea" which may not be copyrighted but not the "expression" which may be protected.

There were reproductions of more than twenty-two paintings of cardinals in evidence, all presumably created under the same conventions and restraints under which the artist here involved worked, and none of them are at all similar to the paintings in issue. The line drawn by the Third Circuit between not copyrighting "the idea" and copyrighting "the expression" cannot be reconciled against the background context of the cardinal paintings done by other artists.

A reproduction of the closest cardinal painting by other artists is reproduced in the appendix to this petition.

National Wildlife first sued Franklin Mint in Florida. Franklin Mint brought a second-filed suit in Pennsylvania and was able to have the Florida action transferred to Pennsylvania because the Florida District Court had a much greater case load than the Pennsylvania District Court.

There was a question of the appealability of the final order in the case. Franklin Mint moved for attorney fees on March 4, 1977, filed a notice of appeal on March 10, the record went to the Court of Appeals on March 30, the appeals were docketed on April 25, and then on May 23 the District Court denied the motion for attorney fees.

Even though the parties had stipulated that the order appealed from was final, the Court of Appeals raised the issue of appealability. Franklin Mint then decided that the order was not final but the Court of Appeals then did nothing further about the matter.

REASONS FOR GRANTING THE WRIT

Paintings and other art work are regularly reproduced in limited editions. Companies purchase the copyrights from the artist and sell the reproductions to the public with the assurance and understanding that they will be unique and therefore of value. Franklin Mint's brochures said each print "will be issued in a *single, strictly limited edition.* After the edition is completed, the master plates used to create the engravings will be destroyed. *And none of these hand-engravings* will ever be issued again."[2]

If a first publisher cannot stop a second publisher from infringing the copyrights on the first publisher's output and thereby maintain the integrity of his offerings, copyrights have no value. An artist should not be able to closely duplicate prior work and pass immunity from copyright infringement on to his publisher.

This Court held that a copyright should be a "valuable enforceable right" *Washington Publishing Co. v. Pearson,* 306 U.S. 30, 36 (1939). The decision below makes a mockery of that holding.

The Third Circuit seemed to feel that it was maintaining the right of artists to express themselves, but all it did was to create chaos in the art world and ruin the business of National Wildlife because its credibility and integrity has been destroyed.

The decision below is precedent setting and it is a very bad precedent which should be reversed. It has far-reaching adverse implications in the art world.

After extensive hearings, Congress passed a new copyright act which became effective January 1, 1978. There

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2. Each of Franklin Mint's so-called *hand-engravings* bear the legend "Printed in Canada."

is absolutely nothing in the new copyright act which says that an artist can closely duplicate prior work and pass immunity from copyright infringement on to his publisher. There is nothing in the old act to that effect either. The test of copyright infringement should be the same without regard to the author.

The Second Circuit Court of Appeals had a similar case in *Gross v. Seligman*, 212 Fed. 930 (2nd Cir. 1914) in which a photographer took a photograph of a nude model and sold it to a first publisher. The photograph sold well. A few years later the photographer took a second photograph of the same model in a very similar pose and sold that to a second publisher. The first publisher sued the second publisher. The Second Circuit granted relief and sustained the copyright. There is a conflict between this decision and that decision.

At the oral argument of this case, the Court of Appeals expressed concern over the appropriate test to be applied to determine substantial similarity for copyright infringement purposes. The circuits do not agree upon this test, see, for instance, *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) at pages 1163-1167 where the Second Circuit's "abstractions test" *Nichols v. Universal Pictures Corporation*, 45 F.2d 119 (2nd Cir. 1930) and that court's "extrinsic" and "intrinsic" tests are discussed.

In its decision, the Third Circuit spoke of painters like Winslow Homer, Monet and Degas, but ignored the current work of the other artists, here wildlife artists, which directly related to the issues before it and the standard from which the works should have been judged. None of the artists referred to by the Third Circuit were painting for limited edition purposes. Modern advances in lithography whereby an original painting can now be reproduced by a printer has spawned a new industry. The decision below will destroy this industry.

Just as this Court laid out the steps to be followed in determining the validity of a patent in *Graham v. John Deere*, 383 U.S. 1 (1966), so the Court should now lay out the steps to be followed in determining copyright infringement.

THE WRIT SHOULD BE GRANTED

(1) To resolve the conflicts between the Second, Third and Ninth Circuits and reverse the erroneous precedent setting decision below.

(2) To decide important questions of Federal law which have not been but should be settled by this Court.

(3) To decide a question of great public interest in the art and publishing worlds.

Respectfully submitted,

WILLIAM C. McCOY, JR.
BOSWORTH, SESSIONS & McCOY
625 National City Bank Building
Cleveland, Ohio 44114
216/781-9050
Counsel for Petitioners

APPENDIX

JUDGMENT ENTRY OF THE COURT OF APPEALS FOR THE THIRD CIRCUIT

(Dated April 17, 1978)

Nos. 77-1525, 77-1526 & 77-1527

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

FRANKLIN MINT CORPORATION

vs.

NATIONAL WILDLIFE ART EXCHANGE INC.
and RALPH H. STEWART
(D.C. Civil No. 76-1935)

NATIONAL WILDLIFE ART EXCHANGE, INC.

vs.

THE FRANKLIN MINT GALLERY OF AMERICAN ART, INC.
(D.C. Civil No. 76-2753)

National Wildlife Art Exchange, Inc. and
Ralph H. Stewart, Appellants in 77-1525

National Wildlife Art Exchange, Inc.,
Appellant in 77-1526

Franklin Mint Corporation,
Appellant in 77-1527

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Present: ALDISERT, VAN DUSEN and WEIS, *Circuit Judges*.

JUDGMENT

These causes came on to be heard on the records from the United States District Court for the Eastern District of Pennsylvania and were argued by counsel on February 22, 1978.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court filed February 22, 1977, be, and the same is hereby affirmed. Costs taxed against appellants in all appeals.

Attest:

/s/ Thomas Quinn
Clerk

OPINION OF THE COURT OF APPEALS FOR THE THIRD CIRCUIT

(Filed April 17, 1978)

Nos. 77-1525, 77-1526 & 77-1527

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

FRANKLIN MINT CORPORATION

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NATIONAL WILDLIFE ART EXCHANGE INC.
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National Wildlife Art Exchange, Inc., and
Ralph H. Stewart, Appellants in 77-1525

National Wildlife Art Exchange, Inc.,
Appellant in 77-1526

Franklin Mint Corporation,
Appellant in 77-1527

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Argued February 22, 1978

Before: ALDISERT, VAN DUSEN and WEIS, *Circuit Judges*.

WEIS, *Circuit Judge.*

Nearly two centuries ago, Lord Mansfield identified the conflicting interests underlying copyright law in his oft quoted warning:

> "[W]e must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded." *Cary v. Longman,* 102 Eng. Rep. 138, 140 (K.B. 1801), *quoting Sayre v. Moore* (Hil. 1785).

The necessity of balancing these divergent concepts is illustrated in this case in which we are asked to determine whether an artist infringed a copyright, which he had once owned, by painting another work portraying the same general subject matter. The district court found no infringement and, being in agreement, we affirm.

In a series of suits and cross suits, Albert Earl Gilbert and Franklin Mint Corporation were accused of infringing on the purported copyright of National Wildlife Art Exchange, Inc. to a painting, "Cardinals on Apple Blossom." After a bench trial the district court found that the copyright was valid, but there had been no copying and, consequently, no infringement. Companion cases of defamation, disparagement, and unfair competition were also decided by the district court but have not been pursued on these appeals, which are confined to the infringement claim.

In late July or early August, 1972, Ralph H. Stewart began to implement a plan of organizing a business enterprise which would publish and market limited edition prints of wildlife. He telephoned Gilbert, a nationally recognized wildlife artist, and asked him to paint a water color of cardinals. Gilbert agreed and in the following months completed "Cardinals on Apple Blossom," using as source material color slides, photographs, sketches, and two stuffed cardinal specimens. He signed and dated the painting, and placed a copyright notice on it before August 25, 1972, the day when Stewart came to the artist's residence and approved the rendition. While there, Stewart gave Gilbert a check in the amount of $1,500, bearing on the back a notation, "For Cardinal painting, 20 x 24 including all rights—reproduction etc." On the following day, Stewart and Gilbert discussed a proposal to incorporate National Wildlife Exchange, Inc. to market prints of Gilbert's future works. They agreed in general on the plan but it was understood that at a later date attorneys for both parties would draw up a contract in terms meeting their approval. Gilbert endorsed Stewart's check and cashed it on August 28, 1972.

Early in September, 1972, Gilbert delivered the painting to Stewart. That same month, Stewart incorporated National and transferred the painting to it. In connection with his activities for National, an outline of the design of "Cardinals on Apple Blossom" was embossed on his white business cards. No color was applied to the design and no copyright notice was printed on the cards.

National placed a representation of the painting in the fall 1972 Newsletter to Members of the Cornell University Laboratory of Ornithology. No copyright notice of National was affixed but Gilbert's was visible. National published a brochure encaptioned "Introducing a First," in December, 1972 which sought orders for prints of "Cardinals on Apple Blossom," and in the next month,

it distributed an edition limited to 300 prints of the painting. All bore Gilbert's copyright notice. A year later, National filed for copyright registration of "Cardinals on Apple Blossom" which was subsequently granted.

Gilbert and National ultimately were unable to agree upon terms of the business venture discussed in August of 1972, and in January, 1975, Gilbert agreed to paint a series of four water color birdlife pictures, including one of cardinals, for Franklin Mint Corporation. The series was completed in January of 1976, and included a work entitled, "The Cardinal." Franklin made engravings of the four paintings which were sold as a group and not separately.

In painting "The Cardinal," Gilbert used some of the same source material he had utilized for "Cardinals on Apple Blossom," including preliminary sketches from his collection, photographs, slides, and a working drawing. In addition, however, he used other slides of foliage taken after completion of the earlier painting and sketches specifically developed for "The Cardinal," as well as a series of cardinal photographs. He did not use the stuffed bird specimens which had served as models for "Cardinals on Apple Blossom."

After hearing extensive testimony and viewing Gilbert's rendition of a cardinal painted in the courtroom during the trial, the district judge found that the artist had not copied "Cardinals on Apple Blossom" when he painted "The Cardinal." The court also determined that title to the copyright of "Cardinals on Apple Blossom" passed to Stewart when he purchased the painting with the $1,500 check bearing a limited endorsement. In addition, the court ruled that distribution of Stewart's business card did not constitute a publication without notice which would

forfeit National's copyright protection. And, since Gilbert's copyright notice appeared on the picture in the Cornell bulletin, the court decided that no forfeiture occurred by such publication.

Unlike a patent, a copyright protects originality rather than novelty or invention—conferring on the owner the sole right to reproduce the work and to "control all the channels through which . . . work or any fragments of . . . work reach the market." Chafee, *Reflections on the Law of Copyright*: *I*, 45 COLUM. L. REV. 501, 505 (1945). It has been said: "Originality in this context 'means little more than a prohibition of actual copying.'" *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951) (citations omitted). If there is no copying, there can be no infringement. *Mazer v. Stein*, 347 U.S. 201, 218 (1954); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904 (3d Cir.), *cert. denied sub nom. Universal Athletic Sales Co. v. Pinchock*, 423 U.S. 863 (1975); *Alfred Bell & Co. v. Catalda Fine Arts, supra*, at 103 & n.16. Copying done from memory is as objectionable as that done by tracing or direct view, *Herbert Rosenthal Jewelry Corp.* v. *Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971); *Withol v. Wells*, 231 F.2d 550 (7th Cir. 1956). Circumstantial evidence of access to the protected work and substantial similarity between it and the alleged infringing work can be used to infer copying when direct evidence is lacking. *See Reyher v. Children's Television Workshop*, 533 F.2d 87 (2d Cir.), *cert. denied*, 429 U.S. 980 (1976); *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *cert. denied*, 330 U.S. 851 (1947).

To reconcile the competing societal interests inherent in the copyright law, copyright protection has been extended only to the particular *expression* of an idea and not to the idea itself. *See Mazer v. Stein, supra* at 217-18;

Baker v. Selden, 101 U.S. 99, 102-03 (1879). In *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926), the court observed:

> "Just as a patent affords protection only to the means of reducing an inventive idea to practice, so the copyright law protects the means of expressing an idea; and it is as near the whole truth as generalization can usually reach that, if the same idea can be expressed in a plurality of totally different manners, a plurality of copyrights may result and no infringement will exist."

See also Comment, *"Expression" and "Originality" in Copyright Law*, 11 Washburn L.J. 440 (1972).

Since copyrights do not protect thematic concepts, the fact that the same subject matter may be present in two paintings does not prove copying or infringement. Indeed, an artist is free to consult the same source for another original painting. As Justice Holmes stated: "Others are free to copy the original [subject matter]. They are not free to copy the copy." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903).

Precision in marking the boundary between the unprotected idea and the protected expression, however, is rarely possible, *see Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931), and the line between copying and appropriation is often blurred. Troublesome, too, is the fact that the same general principles are applied in claims involving plays, novels, sculpture, maps, directories of information, musical compositions, as well as artistic paintings. Isolating the idea from the expression and determining the extent of copying required for unlawful appropriation necessarily depend to some degree on whether the subject matter is words or symbols written on paper, or paint brushed onto canvas.

Moreover, in the world of fine art, the ease with which a copyright may be delineated may depend on the artist's style. A painter like Monet when dwelling upon impressions created by light on the facade of the Rouen Cathedral is apt to create a work which can make infringement attempts difficult. On the other hand, an artist who produces a rendition with photograph-like clarity and accuracy may be hard pressed to prove unlawful copying by another who uses the same subject matter and the same technique.[1] A copyright in that circumstance may be termed "weak," *see First American Artificial Flowers, Inc. v. Joseph Markovits*, 342 F.Supp. 178, 186 (S.D.N.Y. 1972), since the expression and the subject matter converge. *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977); *Herbert Rosenthal Jewelry Corp. v. Kalpakian, supra.* In contrast, in the impressionist's work, the lay observer will be able to differentiate more readily between the reality of subject matter and subjective effect of the artist's work. The limitations imposed upon the artist by convention are also factors which must be considered. A scientific drawing of a bird must necessarily be more similar to another of the same nature than it would be to an abstract version of the creature in flight.

The "copying" proscribed by copyright law, therefore, means more than tracing the original, line by line. To some extent it includes the appropriation of the artist's thought in creating his own form of expression. In *Uni-*

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1. *Compare* Esquire, Inc. v. Varga Enterprises, Inc., 81 F.Supp. 306, 307-08 (N.D. Ill. 1948), *aff'd in relevant part, rev'd in part*, 185 F.2d 14, 20 (7th Cir. 1950), *with* Gross v. Seligman, 212 F. 930 (2d Cir. 1914).

versal Athletic Sales Co. v. Salkeld, supra at 907, we observed:

> "To establish a copyright infringement, the holder must first prove that the defendant has copied the protected work and, second, that there is a substantial similarity between the two works. . . . Phrased in an alternative fashion, it must be shown that copying went so far as to constitute improper appropriation, the test being the response of the ordinary lay person."

In that case, the district court had found copying but made no specific finding that would meet the second test—"that of substantial similarity in the sense of an appropriation of the original work." Copying which had been determined by dissection of the two works at issue was not sufficient, we said, because:

> "substantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement. As the *Arnstein* case points out, dissection and expert testimony in the former setting are proper but are irrelevant when the issue turns to unlawful appropriation." *Id.*

In the case *sub judice*, testimony was presented by experts for the respective parties to support and refute substantial similarity. There are indeed obvious similarities. Both versions depict two cardinals in profile, a male and a female perched one above the other on apple tree branches in blossom. But there are also readily apparent dissimilarities in the paintings in color, body attitude, position of the birds and linear effect. In one, the male cardinal is perched on a branch in the upper part of the picture and the female is below. In the other, the positions of the male and female are reversed. In one, the attitude of the male is calm; in the other, he is agitated

with his beak open. There is a large yellow butterfly in "Cardinals on Apple Blossom," and none in "The Cardinal." Other variances are found in the plumage of the birds, the foliage, and the general composition of the works. Expert testimony described conventions in ornithological art which tend to limit novelty in depictions of the birds. For example, minute attention to detail of plumage and other physical characteristics is required and the stance of the birds must be anatomically correct.

There was also testimony on the tendency of some painters to return to certain basic themes time and time again. Winslow Homer's schoolboys, Monet's facade of Rouen Cathedral, and Bingham's flatboat characters were cited. Franklin Mint relied upon these examples of "variations on a theme" as appropriate examples of the freedom which must be extended to artists to utilize basic subject matter more than once. National vigorously objects to the use of such a concept as being contrary to the theory of copyright. We do not find the phrase objectionable, however, because a "variation" probably is not a copy and if a "theme" is equated with an "idea," it may not be monopolized. We conceive of "variation on a theme," therefore, as another way of saying that an "idea" may not be copyrighted and only its "expression" may be protected.

The district court had the opportunity to hear the testimony from the artist and found credible his statement that he did not copy. For further support, Gilbert painted a third picture, "The Cardinal" while in the courtroom and without referring to either of his earlier paintings. The court determined that although some of the same source materials were used in all three paintings, similarity between the works necessarily reflected the common theme or subject and each painting was a separate artistic effort.

It is well settled that credibility determinations are uniquely the province of the fact-finder. *Government of the Virgin Islands v. Gereau*, 502 F.2d 914, 921 (3d Cir. 1974), *cert. denied*, 420 U.S. 909 (1975). Although evidence of access and similarity between the paintings constitute strong circumstantial evidence of copying, they are not conclusive, *Herbert Rosenthal Jewelry Corp. v. Kalpakian, supra*, 2 M. NIMMER ON COPYRIGHT, §§ 139.4 at 605, 141.2 at 613-14 (1976). The trial court's finding of no copying, based as it is on the testimony of the artist and other evidence of creativity, may be overturned only if it is clearly erroneous. *Rosen v. Loew's, Inc.*, 162 F.2d 785 (2d Cir. 1947). This situation is different from that in *Universal Athletic Sales Co. v. Salkeld, supra*, where we passed on the question of similarity between the copyrighted and accused work *after* copying had been established to determine if there had been appropriation. There, we were in as good a position to make a judgment as the trial court. Here, however, we have not had the opportunity to hear and see the witnesses and, thus, are not in the position to judge credibility as was the district judge. Accordingly, we conclude that the district court did not err in finding that there was no copying.

Even if it be assumed that the trial court's finding was based only on an application of a mechanical standard of copying—a tracing concept—without consideration of the appropriation factor, we would affirm. We have examined the two paintings and based upon our own observations and impressions, we conclude that while the ideas are similar, the expressions are not. A pattern of differences is sufficient to establish a diversity of expression rather than only an echo. *Universal Athletic Sales Co. v. Salkeld, supra; Herbert Rosenthal Jewelry Corp. v. Kalpakian, supra* at 741-42. The similarities here are of a nature not calculated to discourage an artist in the

development of a specialty yet sufficiently distinguishable to protect his creativity in that sphere. Just as Justice Holmes would not ban the ballerinas of Degas, we may not excommunicate the Cardinals. *See Bleistein v. Donaldson Lithographing Co., supra* at 251.

We conclude that the district judge did not err in finding that there was no copyright infringement. Consequently, we need not decide whether there was a forfeiture of the copyright by publication of the business cards. Similarly, since there was no infringement established, we do not address ourselves to the issue of whether the district court erred in finding that National had acquired Gilbert's copyright.

The judgment of the district court will be affirmed.

/s/ Joseph Weis, J.
Circuit Judge

MEMORANDUM OPINION OF THE DISTRICT COURT

(Filed March 15, 1977)

IN THE UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF PENNSYLVANIA

FRANKLIN MINT CORPORATION v. NATIONAL WILDLIFE ART EXCHANGE, INC., and RALPH H. STEWART	Civil Action No. 76-1935
ALBERT EARL GILBERT v. NATIONAL WILDLIFE ART EXCHANGE, INC.	Civil Action No. 76-1956
NATIONAL WILDLIFE ART EXCHANGE, INC. v. THE FRANKLIN MINT GALLERY OF AMERICAN ART, INC.	Civil Action No. 76-2753

MEMORANDUM OPINION*

The above three cases involving the validity of a copyright and disputes related thereto, have been consolidated for this bench trial. I make the following:

*The following opinion was dictated from the bench, transcribed by the court reporter, and edited for minor corrections of errors that appeared in the stenographic transcript.

FINDINGS OF FACT:

1. National Wildlife Art Exchange, Inc. ("National"), is a Florida corporation with its principal office in Vero Beach, Florida.

2. Franklin Mint Corporation ("Franklin") is a Pennsylvania corporation with its principal office in Franklin Center, Pennsylvania.

3. Albert Earl Gilbert ("Gilbert") is an adult individual who at all times material to these proceedings was a citizen and resident of Connecticut.

4. Gilbert is a self-taught wildlife artist and is reputed to be one of the foremost contemporary wildlife artists in the United States.

5. Ralph H. Stewart ("Stewart") is an adult individual who at all times material to these proceedings was a citizen and resident of Vero Beach, Florida.

6. Stewart, a college graduate, is a public accountant and has worked in matters of public finance and record keeping for municipal officials in Indian River County, Florida.

7. Stewart was the principal incorporator of National, and at all times material to these proceedings was its majority stockholder and chief operating officer. Stewart transacted business in the Commonwealth of Pennsylvania on behalf of National as well as on his own behalf.

8. In June, 1971, Gilbert and Stewart entered into a written contract pertaining to the marketing of prints of Gilbert's painting of a peregrine falcon. This venture was abandoned and the painting was subsequently returned to Gilbert by Stewart.

9. In late July or early August, 1972, in a telephone conversation, Stewart asked Gilbert to paint a water color picture of cardinals.

10. In this telephone conversation Stewart informed Gilbert that he, Stewart, now had sufficient capital to organize a business to publish and market limited edition prints of wildlife subjects.

11. Gilbert orally agreed with Stewart to prepare a water color painting of cardinals with the understanding that Stewart, if he did not approve of the painting, would have no economic obligation to Gilbert.

12. The terms of the oral agreement did not provide any advance financing from Stewart to Gilbert.

13. Thereafter, during August of 1972, Gilbert painted "Cardinals on Appleblossom" using as his source material certain 35 mm color slides, photographs, sketches and two stuffed cardinal specimens. None of this source material was supplied by Stewart.

14. On August 25, 1972, Stewart came to Gilbert's residence in Connecticut, which at that time was in Ridgefield, to view "Cardinals on Appleblossom". Prior to August 25, 1972, Gilbert had signed and dated the painting and placed a copyright notice upon it.

15. In the late afternoon of August 25, 1972, Stewart approved of "Cardinals on Appleblossom" and delivered a check made payable to Gilbert in the amount of $1,500.

16. This check was drawn on Stewart's personal account as a public accountant.

17. Before delivering the check to Gilbert, Stewart endorsed on the back of the check the following legend: "For Cardinal painting 20 x 24 including all rights—reproduction, etc." On August 28, 1972, Gilbert endorsed the check and had it deposited for collection.

18. It was the intention of the parties that Stewart would purchase "Cardinals on Appleblossom" for the sum of $1,500.

19. On Saturday, August 26, 1972, Stewart and Gilbert conferred at Gilbert's home.

20. During this conference Stewart made certain notes outlining a proposed transaction between Stewart and Gilbert which transaction contemplated the incorporation of National.

21. Stewart and Gilbert executed the notes for the purpose of evidencing mutual good faith, but both intended that the notes would be placed in legal form by Stewart's attorney and subsequently approved by an attorney to be engaged by Gilbert.

22. In early September, 1972, Gilbert, after placing some finishing touches on "Cardinals on Appleblossom", hand delivered that painting to Stewart in Florida.

23. In September, 1972, Stewart caused the incorporation of National to take place and thereafter received reimbursement from National for the $1,500 he paid to Gilbert.

24. Stewart subsequently delivered the notes taken at the August 26, 1972, meeting to his attorney in Florida for the preparation of a formal contract to be submitted to Gilbert.

25. In the fall of 1972 Stewart began making arrangements to market limited edition prints of "Cardinals on Appleblossom".

26. The prints of "Cardinals on Appleblossom" were to be made by lithography.

27. In the fall of 1972 Stewart caused an outline of the design "Cardinals on Appleblossom" to be embossed on his white business card. No color was utilized in depicting the design. No copyright notice appeared on the business card. Between 375 and 800 cards were distributed.

28. Stewart caused a representation of "Cardinals on Appleblossom" to be placed in the fall 1972 Bulletin of the Cornell University Laboratory of Ornithology with no copyright notice of National appearing thereon although the copyright notice of Gilbert appeared thereon.

29. On December 14, 1972, National published and distributed a brochure entitled "Introducing a First", which contained laudatory information about Gilbert, and sought orders for prints of "Cardinals on Appleblossom".

30. In January of 1973 and thereafter National distributed prints of "Cardinals on Appleblossom" which were represented by National to be part of a limited edition not to exceed 300 signed and numbered prints.

31. Both the brochure and the prints contained copyright notices in favor of Gilbert.

32. The Florida attorney for National and Stewart completed a draft of a written contract based upon the notes of the August 26, 1972, meeting.

33. Stewart substantially revised the draft prepared by his attorney and in June, 1973, submitted the revision to Gilbert.

34. Gilbert never executed the written contract revised by Stewart.

35. On December 18, 1973, National filed for copyright registration for the print "Cardinals on Appleblossom" and the brochure featuring that work.

36. At the time of said filing, National attached to its application the notes made by Gilbert on August 26, 1972, and stated in its application that Gilbert was an "artist for hire".

37. Thereafter, the Copyright Office issued copyright registration to National for "Cardinals on Appleblossom".

38. On November 9, 1972, Franklin inquired of Gilbert whether he was available to do artistic work for Franklin.

39. Gilbert referred this inquiry to National and Stewart.

40. Thereafter, Gilbert disassociated himself from National and from Stewart and in January, 1975, entered into a contractual arrangement with Franklin to paint a series of water color birdlife pictures.

41. Although at one point twenty separate paintings were contemplated, Gilbert was commissioned by Franklin to paint four, including a rendition of cardinals.

42. By January 28, 1976, Gilbert completed the four bird paintings for Franklin, including a work entitled "The Cardinal".

43. Franklin engaged an expert engraver to make engravings of the four paintings.

44. The technique Franklin developed for reproducing Gilbert's paintings included the making of a black and white engraving by applying seventeen tons of pressure per square inch to the paper, and thereafter, adding the color by lithography.

45. Franklin marketed the four prints by accepting orders for the series up to but not beyond a stated date. The purchaser was required to order all four prints.

46. The series included portrayals of two birds of prey (raptors) and two song birds (passerines).

47. Gilbert designed the painting of "The Cardinal" to be complementary in design and color to the painting of the other passerine bird entitled "The Bluejay".

48. Gilbert utilized in painting "The Cardinal" some of the same source material he had used for "Cardinals on Appleblossom". The similar source material included sketches of cardinals from Gilbert's sketch book, photographs and 35 mm slides of foliage. Gilbert also referred to a working drawing of "Cardinals on Appleblossom" when he painted "The Cardinal".

49. Gilbert, in painting "The Cardinal", used some different source materials from that which he used in painting "Cardinals on Appleblossom". The different source material included photographic slides of foliage which were taken after "Cardinals on Appleblossom" was completed.

50. There are similarities between "Cardinals on Appleblossom" and "The Cardinal" including:

(a) Both depict two cardinals, one a male and the other a female.

(b) The cardinals in both are perched on forked apple branches which are in blossom.

(c) In both pictures, the beak of one of the birds is open.

(d) The presentation of the birds in both pictures is similar in that one is above the other and they are facing to the viewer's right.

(e) Some of the foliage in both pictures is similar.

(f) The legs of the birds in both pictures are similar.

51. There are differences between "Cardinals on Appleblossom" and "The Cardinal" including:

(a) "Cardinals on Appleblossom" has as one of its three focal points a large yellow butterfly while there is no butterfly in "The Cardinal", which has only two focal points;

(b) The female cardinal is at the top of "Cardinals on Appleblossom" and at the bottom of "The Cardinal".

(c) The male cardinal in "Cardinals on Appleblossom" is leaning toward the large butterfly with his beak open, his tail feathers fanned and his crest erect. The male cardinal in "The Cardinal" is less agitated.

(d) There is a small leafhopper near the female cardinal in "Cardinals on Appleblossom" while there are no insects depicted in "The Cardinal".

(e) The blossoms shown in "The Cardinal" are in a later stage of development than in "Cardinals on Appleblossom".

(f) "The Cardinal" is complementary to "The Bluejay" while "Cardinals on Appleblossom" is not.

(g) The attitude or posture of the cardinals in the two pictures is dissimilar.

(h) Some of the foliage in "The Cardinal" is different from the foliage in "Cardinals on Appleblossom".

(i) There are discernible differences in the color and feathers between the birds in "The Cardinal" and the birds in "Cardinals on Appleblossom".

(j) "The Cardinal", being engraved contains numerous black lines illustrating body feathers which lines do not appear on "Cardinals on Appleblossom."

52. "The Cardinal" is not traced from "Cardinals on Appleblossom".

53. "The Cardinal" is not a free-hand copy of "Cardinals on Appleblossom".

54. "The Cardinal" is not copied from "Cardinals on Appleblossom".

55. On December 3, 1976, the Copyright Office, because of date discrepancies in the application, requested National to return its certificate of copyright registration GP 89824, on "Cardinals on Appleblossom" for cancellation.

56. On or about January 12, 1977, the Copyright Office reissued a copyright registration to National for "Cardinals on Appleblossom".

DISCUSSION

In this case National is suing Franklin for equitable relief and money damages for copyright infringement, defamation and unfair competition. Franklin seeks declaratory and injunctive relief against National and Stewart to confirm noninfringement and, in addition, claims money damages for defamation. Gilbert requests injunctive and declaratory relief against National to confirm noninfringement as well as money damages for defamation.

By agreement of counsel and with the concurrence of the court, the liability issues will first be decided, and

if National is entitled to money damages, further hearings will be held. The liability phase of this litigation involves the resolution of four principal issues which are: is National entitled to copyright "Cardinals on Appleblossom"; if so, are National's copyrights valid; if they are, does "The Cardinal" infringe National's copyrights; and has any party made out a case in his or its favor of defamation, disparagement or unfair competition?

I. *Entitlement to the Copyright*

Franklin and Gilbert dispute National's alleged ownership of the copyrights to "Cardinals on Appleblossom". In its December 18, 1973, filing with the Copyright Office, National relied on the notes of the August 26, 1972, meeting to pass title to the right to copyright "Cardinals on Appleblossom". However, those notes, signed by Gilbert and Stewart, consist of scribbling which is difficult to decipher. Stewart's attorney was unable to prepare an acceptable draft of a formal contract from those notes. In some instances Stewart and his attorney made subsequent additions to the notes. In any event, the notes can rise no higher than a letter of intent, and under Florida law, which the parties stipulated to be applicable to the notes, an agreement to enter into an agreement is unenforceable. *See Brown v. Dobry,* 311 So.2d 159 (Fla. Dist. Ct. App. 1975); *O'Neill v. Corporate Trustees, Inc.,* 376 F.2d 818 (5th Cir. 1967). Furthermore, the notes dated August 26, 1972, referred to future paintings and "Cardinals on Appleblossom" had been purchased by Stewart the previous day. Therefore, no title to that work could pass under any interpretation of the notes.

However, it was the intent of Gilbert and Stewart that Stewart purchase "Cardinals on Appleblossom" for the sum of $1,500, and on August 25, 1972, Stewart de-

livered a check in that amount to Gilbert. Before doing so, Stewart endorsed on the back of the check, "For Cardinal painting 20 x 24 including all rights—reproduction, etc." Gilbert and Franklin contend that the sale was limited to the painting and the right to reproduce the painting but did not include the right to the copyright. Except in California and New York, it is generally accepted that purchase of a work of art includes all rights to copyright unless otherwise specified. NIMMER ON COPYRIGHT, page 541 (1976 ed.). Nimmer, though, is critical of this rule and terms it "unfortunate". According to Nimmer, the average artist who sells a painting to a private purchaser would "be most surprised to find that he has thereby divested himself of the right to sell post card or art-book reproductions of the work". Nimmer would decide this issue by reference to the intention of the parties. Although Gilbert testified that he intended to reserve copyrights in himself, he either should have done so by specific written agreement or not negotiated the check with the above-quoted endorsement which specifically included "all rights-reproduction". Neither was Stewart an ordinary private purchaser. Gilbert knew of Stewart's desire to market reproductions of his work of art. While Gilbert denies that he knew of the endorsement when he accepted the check and testified he first learned of it on August 28, 1972, he still could have protected himself by insisting on a check from Stewart without the endorsement or with a clarified endorsement. In this regard it should be noted that Gilbert did not deliver the painting to Stewart until approximately September 2, 1972, when he hand carried it to Florida. Therefore, I find as a fact and conclude that entitlement to all copyrights to "Cardinals on Appleblossom" passed to Stewart by virtue of the $1,500 check and the endorsement contained on the reverse side. Also, an assignment of Stewart's rights to National was con-

summated when Stewart was reimbursed for the $1,500 he had paid Gilbert.

Franklin and Gilbert introduced evidence that Stewart, following August 25, 1972, acknowledged the copyright was Gilbert's property, Stewart prepared a short-form assignment of the copyright interest in "Cardinals on Appleblossom", executed it himself and sent it to Gilbert for execution. This short form contained a recital that Gilbert was the owner of the copyright. It is urged by Franklin and Gilbert that Stewart's execution of the assignment form is an admission of the facts set forth in the recital. I reject this argument. A more likely explanation is that Stewart was seeking confirmation of his prior understanding. Also, Gilbert and Franklin introduced correspondence from Stewart which could be interpreted as confirming ownership of the copyright interest in Gilbert. Although Stewart did not choose his language carefully in correspondence subsequent to August 25, 1972, the fact remains that he previously paid $1,500 for the painting. Finally, Gilbert and Franklin contend that National's reliance on the check of August 25, 1972, to establish entitlement to the copyright is an afterthought because initially National based its claim on the notes of August 26, 1972. While that may be true, it does not change the legal effect of the August 25, 1972, transaction and the endorsement on the check delivered in consummation thereof.

II. *Validity of National's Copyright*

Gilbert and Franklin suggest that National has forfeited any of its rights to secure a copyright by publishing on Stewart's business card, without a copyright notice, a design taken from "Cardinals on Appleblossom". Stewart was identified on the business card as president of National. The design on the business card contains no color and consists of a white on white embossment or

raised impression outlining the cardinals, the butterfly and the foliage of "Cardinals on Appleblossom". Between 375 and 800 of these cards were distributed by Stewart. A similar argument is made that forfeiture of the right to obtain a copyright occurred when National caused a small picture of "Cardinals on Appleblossom" to appear in the fall, 1972, Bulletin of the Cornell University Laboratory of Ornithology.

I find that forfeiture did not occur in either instance. The distribution of the business card is not a case where the work of art or a reproduction thereof was distributed or published without the copyright notice. The size of the design on the business card is greatly reduced from the original painting, lacks color, and is presented in a different medium. In regard to the Cornell newsletter, Gilbert's copyright appears thereon although because of the reduction in size, the encircled "c" is difficult to discern. Franklin and Gilbert rely on *Eagle-Freedman-Roedelheim Co. v. Allison Mfg. Co.*, 204 F.Supp. 679 (E.D. Pa. 1962), and *Letter Edged in Black Pr. v. Public Building Commission of Chicago*, 320 F.Supp. 1303 (N.D. Ill. 1970), for the rule that publication with the omission of an appropriate copyright notice forfeits copyright protection regardless of intent. The difficulty with Franklin's forfeiture argument is illustrated by the following quotation from NIMMER ON COPYRIGHT, page 220: "Unless the basic work is reproduced (either in basic or derivative form) in the published work, it is not published." Under the circumstances present in the case *sub judice*, I find no forfeiture of copyright protection took place, because the distribution of the business card was not a publication of "Cardinals on Appleblossom".

Gilbert and Franklin also dispute the validity of National's copyright on the ground that Stewart and National

committed fraud on Gilbert and the Copyright Office. While Stewart's arrangement with Gilbert should not serve as a model of copyright practice, neither party was initially represented by an attorney. Stewart obtained all right, title and interest to "Cardinals on Appleblossom", including all copyright rights, by paying $1,500. His actions taken thereafter were done to secure his investment and, in retrospect, his documentation may have contained certain overstatements of his position. I find, however, Franklin and Gilbert have not met the burden of proving National and Stewart intended to deceive Gilbert or the Copyright Office in regard to registering the copyright for "Cardinals on Appleblossom". In patent cases, the burden to establish fraud on the Patent Office requires "clear, unequivocal and convincing" proof. *Baldwin-Lima-Hamilton Corp. v. Tatnall Meas. Sys. Co.*, 169 F.Supp. 1, 25 (E.D. Pa. 1958), *aff'd*, 268 F.2d 395 (3d Cir.), *cert. denied*, 361 U.S. 894 (1959). Neither Franklin nor Gilbert has met that heavy burden which should be equally applicable to the Copyright Office.

Franklin and Gilbert raise other technical defenses to the validity of National's copyright registration for "Cardinals on Appleblossom". One of these is that the copyright notices were in Gilbert's name while the registration was under the name of National. However, NIMMER, *supra*, at page 535, states that failure to record an assignment is not a defense to an infringer. As a result of this litigation, the Copyright Office recalled the registration and sought clarification on certain matters. Thereafter, on or about January 12, 1977, the Copyright Office reissued the registration. Suffice it to say that I conclude National has a valid copyright registration for "Cardinals on Appleblossom".

III. *The Infringement Issue*

In this circuit, to establish copyright infringement:

> [t]he holder must first prove that the defendant has copied the protected work and, second, that there is a substantial similarity between the two works. The criterion for the latter requirement is whether an ordinary lay observer would detect a substantial similarity between the works.

University Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975). Gilbert acknowledges that he had copies of "Cardinals on Appleblossom" on his premises at the time he painted "The Cardinal". Therefore, National has proved the element of access. It is equally clear from a visual inspection that "The Cardinal" is not a tracing of "Cardinals on Appleblossom". Nor did Gilbert copy, in the sense of free-hand copying, directly from the earlier painting to the later work.

National contends, however, that the duplication of a copyrighted original, although not exact, gives rise to a cause of action for infringement. National relies heavily on *Gross v. Seligman,* 212 F. 930 (1914) which involved alleged infringement of a copyrighted photograph. In *Gross,* a photographer sold all his rights to the first picture and two years later photographed the same model in substantially the same pose. The court in finding infringement first observed [p. 931]:

> If the copyrighted picture were produced with colors on canvas, and were then copyrighted and sold by the artist, he would infringe the purchaser's rights if thereafter the same artist, using the same model, repainted the same picture with only trivial variations of detail and offered it for sale.

According to National, the quoted language is controlling because in its view Gilbert's "The Cardinal" is a repainting "with only trivial variations" from "Cardinals on Appleblossom".

A more detailed discussion of the *Gross* case is necessary. The photographs in *Gross* were of the same nude model. The only differences in the subsequent photograph from the former were the configuration of the model's mouth, changes in her contours, slight changes in the background and the placing of a cherry stem in her teeth. In this factual context a finding was made that the later photograph was copied from the former, because a comparison revealed no difference in artistic expression. The basis for the finding of infringement in *Gross* is that the artist used his talent "not to produce another picture, but to duplicate the original".

National's reliance on *Gross* is misplaced for several reasons. The *Gross* case has been described as a "curious holding". *Copyright Protection for the Collection and Representation of Facts,* 76 HARV. L. REV. 1569, 1599 (1963). The *Gross* opinion, p. 931, itself contains an exception to the principle it applies.

> Of course when the first picture has been produced and copyrighted every other artist is entirely free to form his own conception of the Grace of Youth, or anything else, and to avail of the same young woman's services in making it permanent, whether he works with *pigments* or a camera. If, by chance, the pose, background, light, and shade, etc., of this new picture were *strikingly similar,* and if, by reason of the circumstance that the same young woman was the prominent feature in both compositions, it might be very difficult to distinguish the new picture from

> the old one, the *new would still not be an infringement of the old* because it is in no true sense a *copy* of the old. (Emphasis supplied, except for word, "copy".)

Furthermore, Gilbert's craft is to depict wildlife as accurately as possible. To do this he relies on source material that he has collected over his lifetime as well as on slides, photographs, sketches, working drawings, and specimens. Mr. Justice Holmes in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903), distinguishes between copying from original subject matter and copying from a finished work of art of a particular subject. He said:

> They seem from the testimony to have been composed from hints or description, not from sight of a performance. But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. *Others are free to copy the original. They are not free to copy the copy.* (Emphasis supplied.)

As I understand this distinction, an artist is permitted to portray cardinals in their natural state as often as he wishes without fear of infringement unless he copies from a previous artistic rendition, including his own. This is made clear by Mr. Justice Holmes later (p. 251) in his opinion:

> Of course, the ballet is as legitimate a subject for illustration as any other. A rule cannot be laid down that would excommunicate the paintings of Degas.

In addition, the *Gross* decision incorrectly relies on *Hanfstaengl v. Baines & Co.*, (L.R. 1895) A.C. 20, as authority

for finding copyright infringement. In actuality, the House of Lords in *Hanfstaengl* found no infringement occurred. At the request of National's attorney, the Court personally verified by telephone conference with the office of the Clerk for the Second Circuit Court of Appeals that there was no typographical error on this point in the printed opinion. Finally, the case at bar falls within the exception stated in *Gross* that the subsequent painting is a new artistic effort.

I am of the opinion that, although there are similarities between "Cardinals on Appleblossom" and "The Cardinal", the latter is a variation on a theme found in nature and is not a copy of the former. The absence of the large yellow butterfly in "The Cardinal" negates any striking similarity.

Expert testimony is admissible on the issue of copying. *Universal Athletic Sales Co. v. Salkeld, supra. Franklin's* experts, including several well-qualified artists and art historians, after reviewing Gilbert's source material, presented convincing opinions that "The Cardinal" is not a copy of "Cardinals on Appleblossom". These experts emphasized that it is accepted practice for artists to return to a common theme such as Claude Monet to haystacks or Winslow Homer to rural school children. Homer, for example, depicted the same children playing the game of snap the whip in two different paintings. The experts referred to a number of other examples where well-known artists consistently returned to a particular theme including Shepherd's charging bull elephants and Albers' colored squares. Also, a leading birdlife artist, Don Eckelberry, testified in Gilbert's behalf on this point. Gilbert as a wildlife artist who strives to be ornithologically correct, is limited in the number of ways he is able to present a particular bird. Gilbert, himself, testified in a credible

manner that he did not copy "The Cardinal" from "Cardinals on Appleblossom".

In support of his denial of the charge of copying, Gilbert painted, using his source materials, a third picture of cardinals. Before commencing this effort, Gilbert was sworn not to refer to "Cardinals on Appleblossom" or "The Cardinal" in any manner until the demonstration painting was completed. All of the work on the painting was done in the courtroom. This third rendition is evidence that Gilbert did not copy "The Cardinal" from "Cardinals on Appleblossom". The third painting, while similar in some respects to both of its predecessors, is in its own right a new work of art. The similarities occur because Gilbert relied on his sketch books, slides, photographs, working drawings, and bird specimens in creating the paintings. Each painting, however, is a separate artistic effort and no copying was done from one finished painting to another.

National insists that Gilbert copied from his pencil sketch working drawing of "Cardinals on Appleblossom" when he outlined "The Cardinal". While this working drawing was referred to by Gilbert, he did not trace or copy from it. The enumerated differences between the paintings are clear evidence that there was no copying. Any impression of similarity is due to the consistency of Gilbert in drawing cardinals with extreme precision in accordance with the artistic convention of presenting the birds in profile as a pair perched on forked limbs.

National's experts did not opine that Gilbert copied "The Cardinal" from "Cardinals on Appleblossom". While they found many similarities and were of the opinion that the two paintings were "too close", their testimony fell short of establishing the essential element of copying.

Both National and Franklin prepared a series of overlays to aid in the comparison of the two works. These overlays do show similarities in composition. They are not particularly helpful, however, because much of Gilbert's talent lies in his faculty of being able to present the cardinals with ornithological precision. Therefore, it is not surprising that the legs of the birds in both works are similar and that other similarities can be found. I have listed in the Findings of Fact the similarities and dissimilarities of "Cardinals on Appleblossom" and "The Cardinal". My own comparison of the paintings,[1] including placing them in juxtaposition with "The Bluejay" leads to the conclusion that Gilbert did not copy "The Cardinal" from "Cardinals on Appleblossom". *See Esquire, Inc. v. Varga Enterprises*, 81 F.Supp. 306, *rev'd on other grounds*, 185 F.2d 14 (7th Cir. 1950).

Even assuming that the similarities between "Cardinals on Appleblossom" and "The Cardinal" would shift (*See* NIMMER ON COPYRIGHT, §139.4) the burden of going forward with the evidence (to prove no copying) to Franklin and Gilbert, I find that the quantum of proof supplied by Franklin and Gilbert meets that burden. The testimony of Gilbert and the opinions of Franklin's experts coupled with my own comparison of the paintings and their source material convince me that Gilbert did not copy. Gilbert impressed me as a sensitive artist with high integrity to

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1. The words of Lord Herschell, over eighty years ago, in Hanfstaengl v. Baines & Co., (L.R. 1895) A.C. 20, 25 are still appropriate today in reaching my conclusion:

> My Lords, it is difficult, if not impossible, to put into words all the reasons which lead to the conclusion arrived at on such a question as that now before your Lordships. I have tried to indicate some of those which have led me to my conclusion; but it depends really on the effect produced upon the mind by a study of the picture, and of that which is alleged to be a copy of it, or at least of its design.

whom the concept of copying would be foreign. At the very least, the evidence presented by Franklin has rebutted any inferences of copying, and the burden of proof has shifted back to National. National has totally failed to counter the thrust of Franklin's formidable proof that no copying occurred. *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718 (9th Cir. 1976).

Since Gilbert did not copy "The Cardinal", there can be no infringement because neither cardinals nor the ballet can be "excommunicated" as subject matter for any artist, irrespective of his talent. In other words, it is the element of actual piracy which is lacking in National's case. *See Rexnord, Inc. v. Modern Handling Systems, Inc.*, 379 F. Supp. 1190 (D. Del. 1974). I find, therefore, that Gilbert has not copied "The Cardinal" from "Cardinals on Appleblossom". Accordingly, an essential element of an infringement action is lacking, and judgment against National will be entered on its claim for infringement. I further find that Franklin and Gilbert are entitled to a declaratory judgment of noninfringement.

IV. *The Defamation Issue*

Franklin has failed to prove the elements of defamation, disparagement and unfair competition in its claim against National. In fact, Franklin withdrew this claim at oral argument. Neither has National introduced any competent evidence against Franklin of defamation or unfair competition. Gilbert individually seeks damages for defamation. Gilbert has sufficiently proved a case of defamation against National in only one respect. National wrote to the National Audubon Society on September 20, 1975, stating Gilbert committed plagiarism in regard to another painting known as "Cardinals in Snow". While Stewart sincerely was of the opinion that his copyright

was infringed, this letter, since it contains an untrue accusation affecting Gilbert's professional status is libelous. No special damages were proved by Gilbert, and his counsel has stated that no additional evidence on damages would be presented. It appears from this record that Gilbert's reputation has not been tarnished by that letter. Therefore, judgment will be entered in favor of Gilbert and against National, but no damages will be awarded to Gilbert. To the extent that the foregoing discussion contains facts and conclusions not specifically set forth in the Findings of Fact and Conclusions of Law, they are incorporated herein by reference. I reach the following:

CONCLUSIONS OF LAW

1. This court has jurisdiction over the subject matter of these disputes pursuant to 28 U.S.C. §1332 and 28 U.S.C. §1338.

2. This court has in personam jurisdiction over all the parties to this litigation, including Ralph H. Stewart, who has been validly served pursuant to 42 Pa.C.S.A. §8309.

3. National Wildlife Art Exchange, Inc., is the owner of all of the right, title and interest in the painting "Cardinals on Appleblossom".

4. National Wildlife Art Exchange, Inc., holds valid copyrights to "Cardinals on Appleblossom".

5. Neither Franklin Mint Corporation nor Albert E. Gilbert has infringed the copyrights of National Wildlife Art Exchange, Inc., to "Cardinals on Appleblossom".

6. Albert E. Gilbert has established by a preponderance of the evidence a cause of action for negligent defamation of character against National Wildlife Art Ex-

change, Inc. However, no special damages were proved and no general damages will be awarded.

7. National has failed to prove by a preponderance of the evidence any cause of action against Franklin for defamation or unfair competition.

8. Judgment is to be entered in accordance with this opinion.

/s/ EDWARD N. CAHN
Edward N. Cahn, J.

First painting—"Cardinals on Apple Blossom"

A38

Second painting "The Cardinal"

A39

Franklin Mint Exhibit 83F—Compositional sketch for first painting used in making second painting

National Wildlife Exhibit 97—Closest cardinal painting by other artist

First Cardinal Painting

Second Cardinal Painting

Supreme Court, U. S.
FILED
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, JR., CLERK

Supreme Court of the United States

October Term, 1977

No. 77-1710

NATIONAL WILDLIFE ART EXCHANGE, INC., AND RALPH H. STEWART,
Petitioners,

vs.

FRANKLIN MINT CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI To the United States Court of Appeals For the Third Circuit

ARTHUR H. SEIDEL
ROBERTA L. JACOBS
SEIDEL, GONDA & GOLDHAMMER, P.C.
600 Three Penn Center Plaza
Philadelphia, Penna. 19102
Counsel for Respondent

Of Counsel:
R. E. LAPORTE
Franklin Mint Corporation
Franklin Center, Penna. 19091

TABLE OF CONTENTS

		Page
I.	Relevant Statutes	1
II.	Questions Presented for Review	2
III.	Statement of the Case	3
IV.	Summary of Argument	6
V.	Argument — Reasons for Denying the Writ	7
VI.	Conclusion	10
	Certificate of Service	10

TABLE OF CITATIONS

Cases

Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 103 (2d Cir., 1951) 9

Baker v. Selden, 101 U.S. 99, 102-103 (1879) ... 8

Esquire v. Varga Enterprises, 81 F. Supp. 306 (N.D. Ill., 1948), affirmed on this point, 185 F.2d 14 (7th Cir., 1950) 8, 9

Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co., 321 U.S. 275, 278 (1944) 7

Gross v. Seligman, 212 F. 930 (2d Cir., 1914) ... 8, 9

Mazer v. Stein, 347 U.S. 201, 217-218 (1954) ... 6, 9

Neil v. Biggers, 409 U.S. 188, 202 (1972) 7

Rosen v. Loew's, 162 F.2d 785, 788 (2d Cir., 1947) 6

United States v. Yellow Cab Co., 338 U.S. 338, 341-342 (1949) 7

Page

Cases:

Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 907 (3d Cir. 1975), cert. denied sub nom. Universal Athletic Sales Co. v. Pinchock, 423 U.S. 863 (1975) 6, 8

Williams v. Kaag Manufacturers, Inc., 338 F.2d 949 (9th Cir., 1964) 8, 9

Zenith Radio Corp. v. Hazeltine Research, 395 U.S. 100, 122-123 (1969) 7

Statutes:

17 U.S.C. §101

17 U.S.C. §102(b)

Supreme Court of the United States

October Term, 1977

No. _____

NATIONAL WILDLIFE ART EXCHANGE, INC., AND RALPH H. STEWART,
Petitioners,

vs.

FRANKLIN MINT CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI To the United States Court of Appeals For the Third Circuit

RELEVANT STATUTES

The Petition for a Writ of Certiorari contains at page 2 the provision of the Copyright Act of 1909, which relates to the subject case, 17 U.S.C. §101.

The relevant provision of the Copyright Act of 1976[1] which relates to the subject case is:

17 U.S.C. §102(b):

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principal or discovery, regardless of the form in which it is described, explained, illustrated or embodied in such work.

1. The Copyright Act of 1976 became effective January 1, 1978, subsequent to the trial of the case at bar which occurred in January 1977.

QUESTIONS PRESENTED FOR REVIEW

1. Whether the findings of fact of the District Court for the Eastern District of Pennsylvania and the Court of Appeals for the Third Circuit, without dissent, that Albert Earl Gilbert (hereinafter "Gilbert") did not copy "Cardinals on Apple Blossom" in creating "The Cardinal" and that "The Cardinal" is not substantially similar to "Cardinals on Apple Blossom" are clearly erroneous.[2]

2. Whether this Court should disturb the findings of fact based on the credibility of Gilbert and of other witnesses observed by the District Judge during a nine-day bench trial.

2. Appended for the Court's information are color reproductions of the two works at issue and the work denominated "The New Cardinal". These reproductions more adequately depict the works than the black and white out-of-focus reproductions appended to the Petition For a Writ of Certiorari.

STATEMENT OF THE CASE

Gilbert is one of the foremost young ornithological artists (R 285, 1299-1300, 1437, 1458).[3]

Ornithological artists generally work in the same manner, from field sketches, specimens and photographs accumulated in the course of a career (R 275-276, 281, 840, 1301). They return to source material previously used for many reasons, including the need to present detail accurately, the need to compensate for seasonal and geographical absence of the subject in nature (R 282-283, 843-845, 851, 889-890, 1314-1315); and the need to return to themes not fully explored or not developed in a satisfactory manner (R 282-283, 285).

Ornithological art follows certain conventions (R 327-328, 1305, 1458). Among these are ornithological accuracy, portrayal of the subject in a characteristic setting and pose, and the representation of individuals of different ages or sexes to show differences within a single species (R 135-136, 321-322, 850). By way of example, because birds are symmetrical on each side, they are normally portrayed in profile except for owls, which are normally portrayed full face (R 307, 848-849, 1307, 1332-1333). These conventions apply to decorative as well as to illustrative works (R 385, 859-860, 1171).

Adoption of a characteristic or conventional pose will give very different works of art a superficial similarity without copying or improper appropriation (R 1332-1334, 1336-1338).

There are only a limited number of ways in which one can portray passerines, such as the cardinal (R 325-327). A cardinal accurately portrayed will of necessity closely resemble any other similarly positioned cardinal accurately portrayed.

3. Citations preceded by "R" are citations to the Appendices filed in Appeal Nos. 77-1525; 1526; and 1527.

Gilbert created "Cardinals on Apple Blossom" from a series of field sketches, slides and stuffed specimens developed into working sketches (R 1101-1119). He created "The Cardinal" using some of this source material, and further working sketches, photographs, and slides taken subsequent to completion of "Cardinals on Apple Blossom" (R 1101-1153, 1181, 1203, 1245-1261).

"The Cardinal" is not a copy of "Cardinals on Apple Blossom", but a variation of the same theme. Artists, including ornithological artists, often create variations of themes they have treated previously (R 1311-1312, 1317-1319, 1324-1328, 1457). Such variations are not copies but new, independent expressions about the same subject. As ornithological artist Eckelberry stated:

> ". . . The intent is to make a variation on a theme. The intent is not to duplicate or replicate, the intent is to somehow adjust the elements to a more satisfactory conclusion." (R 287)

The statement of the case submitted on behalf of National Wildlife Art Exchange, Inc. (hereinafter "National") and Ralph H. Stewart (hereinafter "Stewart") not only ignores these salient facts but contains numerous misstatements of the record of varying degrees of importance.[4] For example, it is alleged at page 4 of the Petition for a Writ of Certiorari (hereinafter "the Petition") that Franklin Mint Corporation (hereinafter "Franklin") was shown only a print of National's painting for "The Cardinal". No citation to the record supports this statement because there is no statement in the record which supports the statement. On the contrary, the record refutes the statement. Franklin was initially shown "Cardinals on Apple Blossom" in addition to many other works of Gilbert at

4. Undoubtedly, the reason why National and Steward did not comply with Rule 40 of this Court, and cite to the record, was to hinder the ready exposure of such misstatements.

the time Gilbert entered into a contractual relationship with Franklin (R 649). At the time Gilbert was creating "The Cardinal", Franklin was shown not "Cardinals on Apple Blossom", but a watercolor painting prepared by Gilbert specifically for use by Yves Beaujard, the engraver assigned by Franklin to work with Gilbert on "The Cardinal" and other works, and possibly a small pencil sketch designed to show the compositional relationship between "The Cardinal" and "The Blue Jay" (R 674-677).[5]

5. In similar fashion, the Petition misstates Gilbert's technique in the creation of "The Cardinal". Page 5 of the Petition asserts that there was no final working sketch for "The Cardinal", the implication being that Gilbert used the final working sketch from "Cardinals on Apple Blossom" for that purpose. However, as Gilbert testified, there were two final working sketches for "The Cardinal" created specifically for "The Cardinal" from material previously collected and created by Gilbert, and from new sketches, photographs and slides taken subsequent to the completion of "Cardinals on Apple Blossom" (R 1103-1153, 1181, 1203).

The opinion of the District Court as well as the record is misrepresented in the Petition. Page 5 of the Petition asserts that the District Court did not pass on the question of substantial similarity to an ordinary lay observer. To the contrary, the District Judge, himself an ordinary lay observer, found:

> "I am of the opinion that, although there are similarities between 'Cardinals on Apple Blossom' and 'The Cardinal', the latter is a variation on a theme found in nature and is not a copy of the former. The absence of the large yellow butterfly in 'The Cardinal' negates any striking similarity." (A 31)

Page 6 of the Petition asserts that a cardinal painting by Ruthven is "the closest cardinal painting by other artists". Whether one of 22 reproductions of cardinals is more like "Cardinals on Apple Blossom" than "The Cardinal" is irrelevant to the question at issue, whether Gilbert copied "Cardinals on Apple Blossom" to create "The Cardinal" and whether "The Cardinal" is substantially similar to "Cardinals on Apple Blossom" in expression. However, there were introduced into evidence depictions of cardinals bearing far closer similarity to "The Cardinal" and "Cardinals on Apple Blossom", than Ruthven's painting. See, particularly, the works of O'Neill, FX 471 at R 1350 and Gronner, FX 82 at R 1346. Similarities among paintings of cardinals are to be expected, because cardinals are living creatures which closely resemble each other.

SUMMARY OF ARGUMENT

Whether Gilbert copied "Cardinals on Apple Blossom" to create "The Cardinal" is a pure question of fact.

This fact question was resolved in the negative by the District Court after a nine-day bench trial (Finding 54 at A22[6]). The District Court, in finding that Gilbert had not copied "Cardinals on Apple Blossom" had the opportunity to listen to and question the witnesses presented by the parties and found Gilbert's testimony to be credible (A 31-32).[7]

The Court of Appeals, on review, without dissent, concluded that the District Court did not err in finding that there was no copying (A 12).

Whether "The Cardinal" is substantially similar to "Cardinals on Apple Blossom" is also a pure question of fact.

This fact question of substantial similarity was resolved in favor of Gilbert and Franklin by both the District Court and the Court of Appeals (A 31, 12).

There is here no dispute as to the relevant legal principles to be applied. There is no dispute that, to prevail on a claim of copyright infringement, the plaintiff must first establish copying and then substantial similarity (A 10), *Rosen v. Loew's*, 162 F.2d 785, 788 (2d Cir., 1947); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975), cert. denied sub nom. *Universal Athletic Sales Co. v. Pinchock*, 423 U.S. 863 (1975). Since ideas, concepts or themes are not subject to copyright protection, *Mazer v. Stein*, 347 U.S. 201, 217-218 (1954); 17 U.S.C. 102(b), the substantial similarity must be in the expression of such ideas, concepts or themes.

---

6. Citations preceded by "A" are citations to the Appendix to the Petition.

7. The Court of Appeals rightly noted that "credibility determinations are uniquely the province of the fact-finder". (A 12).

ARGUMENT — REASONS FOR DENYING THE WRIT

F.R.C.P. 52(a) provides that "findings of fact shall not be set aside unless clearly erroneous . . .".

This Court follows the "clearly erroneous" requirement, *United States v. Yellow Cab Co.*, 338 U.S. 338, 341-342 (1949); *Zenith Radio Corp. v. Hazeltine Research*, 395 U.S. 100, 122-123 (1969).

Also, only in an exceptional case will this Court set aside findings when made, as here, by a District Court, and examined and accepted by a unanimous Court of Appeals, *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co.*, 321 U.S. 275, 278 (1944); *Neil v. Biggers*, 409 U.S. 188, 202 (1972).

The District Court found as facts that Gilbert's "The Cardinal" was not copied from "Cardinals on Apple Blossom" and that there was no such similarity between the works as would rise to the level of improper appropriation (Findings 51 and 54 at A 21, 22), and so concluded as a matter of law (A 35) that there was no copyright infringement. The Court of Appeals affirmed unanimously, finding there was substantial evidence to support the District Court's determination (A 6, 10-12).

In addition, the Court of Appeals made its own independent factual finding based on its observations and impressions after seeing "Cardinals on Apple Blossom" and "The Cardinal" in open court, A 12-13:

> ". . . we conclude that the District Court did not err in finding that there was no copying.
>
> Even if it be assumed that the Trial Court's finding was based only on an application of a mechanical standard of copying — a tracing concept — without consideration of the appropriation factor, we would affirm. We have examined the two paintings and based upon our own observations and impressions, we conclude that while the ideas are similar, the expressions are not. A pattern of

differences is sufficient to establish a diversity of expression rather than only an echo. . . . The similarities here are of a nature not calculated to discourage an artist in the development of a specialty yet sufficiently distinguishable to protect his creativity in that sphere. Just as Justice Holmes would not ban the ballerinas of Degas, we may not excommunicate the cardinals." [Citations omitted]

The decision of the District Court affirmed by the Court of Appeals is in accord with well-established precedent insofar as legal standards are involved. *Esquire v. Varga Enterprises*, 81 F.Supp. 306 (N.D. Ill., 1948), affirmed on this point, 185 F.2d 14 (7th Cir., 1950); *Williams v. Kaag Manufacturers, Inc.*, 338 F.2d 949 (9th Cir., 1964); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904 (3d Cir., 1975), cert. denied, 423 U.S. 863 (1975).

At pages 7 and 8 of the Petition, reference is made to the Copyright Act of 1976 and there is some implication that the decisions below are somehow not in accord with that Act.

The decisions below, however, are wholly in accord with past precedent as embodied in 17 U.S.C. §102(b) which provides that no copyright protection may be secured for an idea or theme, *Baker v. Selden*, 101 U.S. 99, 102-103 (1879). Thus, portraying a male and female cardinal according to certain established artistic conventions is an idea, concept or theme. Any artist may create one or more variations of that theme without infringing on any copyright in prior depictions of that theme so long as those variations comprise different expressions of the theme, as in the instant matter (R 221-223, 857-881, 1015-1016, 1020-1021, 1036-1041, 1145-1151, 1272-1277, 1340-1345).

It is argued at page 8 of the Petition that there is a conflict in the Circuits. There is no such conflict in law. *Gross v. Seligman*, 212 F. 930 (2d Cir., 1914) is distinguishable from this matter, from *Esquire v. Varga Enterprises, supra.*, and from *Williams v. Kaag Manufacturers, Inc., supra.*, on its facts. *Gross*, as opposed to these other decisions, involved photography, and no significant difference in expression was found, no variation on the theme of the earlier work.

In sum, what is at issue herein is a question of fact. It has been found by two courts as a fact that Gilbert did not copy "Cardinals on Apple Blossom" to create "The Cardinal", so that there can be no infringement of copyright, *Mazer v. Stein*, 347 U.S. 201, 218 (1954); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir., 1951); and that "The Cardinal" is not substantially similar in expression to "Cardinals on Apple Blossom". Both findings are amply supported by the voluminous record herein.

There is no conflict of law between the Second, Third, Seventh and Ninth Circuits nor is there involved here any important question of law which has not been but should be settled by the Supreme Court. There is no doubt but that the same legal principles apply irrespective of the identity of the creator of the works in issue.

Because of the factual nature of the issues herein, and because each question of copyright infringement must be decided on its facts, there is no question of great public interest to the art or publishing worlds.

CONCLUSION

Accordingly, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

ARTHUR H. SEIDEL
Seidel, Gonda & Goldhammer, P.C.
600 Three Penn Center Plaza
Philadelphia, Penna. 19102
215-568-8383
Counsel for Respondent,
Franklin Mint Corporation

Of Counsel:
R. E. LAPORTE
Franklin Mint Corporation
Franklin Center, Pa. 19091

CERTIFICATE OF SERVICE

I hereby certify that on this 26th day of June, 1978 three copies of the Brief in Opposition to Petition for a Writ of Certiorari were served by First Class Mail on William C. McCoy, Jr., Esquire, 625 National City Bank Building, Cleveland, Ohio 44114, counsel for Petitioners. I further certify that all parties required to be served have been served.

ARTHUR SEIDEL

Ornithological artist Don R. Eckelberry explained why the cardinal or any other bird of one artist inevitably looks similar to birds of the same species he has depicted:

> " . . . The difference between a wave and a Puffin is considerable. I mean, a wave is a formless thing. It changes its shape constantly, but a Puffin, that's it.
>
> Q. So with a Puffin one must reproduce what is in nature exactly?
>
> A. You don't have the flexibility. You see, a wave is a formless thing. You can do things with it; a sky, a lake, a pond, anything like that. You can have it any color, you can have it calm, you can do anything, but you can't change the color of the Puffin, you can't change the shape of a Puffin, you can't change his flight habit, you can't change a thing about the Puffin if you're really trying to paint a Puffin; it's as simple as that." (R 321-322)

"Cardinals on Apple Blossom" — FX 1

"After hearing extensive testimony and viewing Gilbert's rendition of a cardinal painted in the courtroom during the trial, the district judge found that the artist had not copied 'Cardinals on Apple Blossom' when he painted 'The Cardinal'." (A 6)

"The Cardinal" — FX 2

"The district court had the opportunity to hear the testimony from the artist and found credible his statement that he did not copy. For further support, Gilbert painted a third picture, 'The Cardinal' while in the courtroom and without referring to either of his earlier paintings. The court determined that although some of the same source materials were used in all three paintings, similarity between the works necessarily reflected the common theme or subject and each painting was a separate artistic effort." (A 11)

"The New Cardinal" — FX 547

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Supreme Court of the United States

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No. 77-1710

NATIONAL WILDLIFE ART EXCHANGE, INC.,
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REPLY BRIEF OF PETITIONERS

WILLIAM C. McCOY, JR.
BOSWORTH, SESSIONS & McCOY
625 National City Bank Building
Cleveland, Ohio 44114
Counsel for Petitioners

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-5647

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REPLY BRIEF OF PETITIONERS

Respondent's brief in opposition to the petition hides behind the "no copying" holding of the lower Courts, but that holding is meaningless. Respondent's position only serves to underscore the reasons why this Court should accept the petition and set out meaningful tests for proof of copyright infringement, as this Court did for patent validity in *Graham v. John Deere*, 383 U.S. 1 (1966).

A new copyright act went into effect on January 1, 1978. This is an age of mass communication with all sorts of copyright/intellectual property/first amendment problems. There are not even any decisions of the Supreme Court under the 1905 Copyright Act which are concerned with substantive copyright infringement questions. The time is ripe for the Supreme Court to provide guidance in this area. The facts of this case are ideal from which to formulate a meaningful test for proof of copyright infringement.

In the leading case of *Arnstein v. Porter*, 154 F.2d 464 at page 468, the Second Circuit held that the elements essential to a copyright infringement case were proof that (a) defendant "copied" from plaintiff's copyrighted work and (b) the copying went so far as to constitute improper appropriation. Proof of the first element usually is access to the copyrighted work and some use of the copyrighted work in the making of the accused work or at least circumstantial evidence of such use. Here the artist had access and he admitted using the final compositional sketch (FX 83F-A39) of the copyrighted work in making the accused work. This should have made out the first element of National's case and the Court should have directed its attention to the second element.

Respondent argues that the holding of "no copying" was a finding of fact, but the works themselves were not considered in reaching that conclusion and the holding is therefore meaningless. The self-serving testimony of the artist was the only basis for that holding. If an artist admits using the copyrighted work in the creation of the accused work but testifies that he did not "copy", what can it mean? Moreover, what artist would ever admit that he did copy?

The District Court said that "it is the element of actual piracy which is lacking in National's case" (A34). Is piracy an essential element of proof in copyright infringement? At some point do the works not speak for themselves?

The intention of Congress is that copyrights be valuable rights, but that intention has been frustrated in this case. This is a David v. Goliath struggle in which the law required wholly unreasonable standards of proof from David.

The lower Courts have definitely applied a wrong test of infringement in this case. They focused on the differences between the works instead of the similarities. They did not consider cardinal paintings by other artists in order to determine the line between an unprotectable idea and an unlawful appropriation of the expression of the idea. They did not determine to what extent the similarities of the first painting had been improperly appropriated or plagarized and used again in the second painting. The lower Courts ignored the base point from which they could have determined the proper scope of copyright protection. If the theme is creative and unique, a variation on that theme should be an infringement, which is the case here.

The negative overlays in the back of the petition show how close the works are. When you look at one work and then the other, the first impression is that they are the same and you have to study them to find the differences.

The third painting done in the Courtroom is not relevant, was objected to, and should not be considered. If anything, it is another infringement and illustrates the infinite possibilities which the decisions below provide to those who wish to appropriate the intellectual property of others. The artist used the final compositional drawing for the first painting, the "mold" (FX 83F—A39) in making the third painting.

Respondent speaks of the conventions of ornithological art, how "The Cardinal" was created and why it is a permissible "variation on a theme" instead of an infringement. However, the Court has only to look at the many various ways of painting cardinals done by other artists in the cardinal paintings in evidence to realize that what the artist did here was wrong. The cardinal paintings of the other ornithological artists are much more relevant to infringement than Winslow Homer's schoolboys.

As Judge Learned Hand said, Franklin Mint should not have been able to excuse "The Cardinal" by showing how much of the copyrighted work had not been pirated, *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2nd Cir.1936).

The Third Circuit said that it would not excommunicate cardinals any more than Justice Holmes would ban the Ballerinas (A13). No one asked them to excommunicate cardinals. Petitioner asked them to excommunicate unlawfully appropriated material, cardinals on a forked branch of an apple tree in blossom which has the same design, impact and impression on the ordinary lay observer as the subject of its copyright when no one else had even used a similar compositional design or even painted cardinals in an apple tree.[1]

It was so easy to avoid infringement, the question should have been why the artist and Franklin Mint felt obligated to do what he did.

Petitioner's statement of the case is correct. The artist testified (R 777) that Franklin Mint did not know that the accused painting was going to involve cardinals on apple blossoms until the finished painting was submitted to the engraver from which he was to copy the published print. Franklin Mint did not see any sketches or layouts of "The Cardinal". This was contrary to its practice followed with respect to the first three paintings of this series wherein Franklin Mint was shown sketches and layouts of the proposed works, as provided in the contract with the artist. Franklin Mint was shown "Cardinals on Apple Blossoms" and knew that it was a success.

National Wildlife Exhibit 97, reproduced in the back of the petition, is the closest cardinal painting by another

1. In reporting on the case the local newspaper reproduced the paintings and got the pictures mixed up (R 1483).

artist in that it has (a) a male and female cardinal one above the other (b) a forked branch and (c) blossoms. No other cardinal painting by any other artist combines these three features, which shows how close the second painting is to the first and how far away the other paintings are. The O'Neill cardinal (FX 471) and the Gronner cardinal (FX 82, Respondent's footnote 5 p. 5) have entirely different compositions.

The works here in issue were not painted from nature. There was no photograph or sketch from life of two cardinals on an apple tree in blossom from which the artist developed these paintings. The paintings were created in the mind of the artist, assembled from source material which can be reassembled in a thousand other ways.

In *Sid & Marty Kroffit Television v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977), the Ninth Circuit analyzed the tests of infringement. It noted the rule that a copyright could not protect an idea but could protect the expression of an idea and called for an "extrinsic" test to determine what the idea was and an "intrinsic" test to determine whether the expression of the idea had been appropriated. But no court tells one how to separate the idea from the expression of the idea. It cannot be done in a vacuum. There are more than twenty-two paintings of cardinals by other artists in the record. They should have been considered because only by surveying this relevant material can one develop any criteria from which to determine where the "idea" leaves off and the "expression of the idea" begins. In patent law you consider the prior art and the level of skill in the art. What should be considered with copyrights?

The Court of Appeals held that a pattern of differences is sufficient to establish a diversity of expression rather than only an echo (A12). But one can copy a single chap-

ter in a book verbatim and be an infringer. One does not have to copy the whole book and the Court should not compare whole books. Differences do not excuse plagarism.

In *Schroeder, et al. v. William Morrow and Company, et al.*, 198 U.S.P.Q. 143 (7th Cir. 1977) a defendant copied names and addresses from a catalogue but not descriptive write-ups. The two catalogues did not look alike. The Court of Appeals looked at the similarities which had been copied, found infringement and reversed the District Court. This Seventh Circuit case is in direct conflict with the decisions below, wherein the Courts looked at the differences.

The Second Circuit found infringement in *Gross v. Seligman*, 212 F. 930 (2nd Cir. 1914), because "the exercise of artistic talent, which made the first photographic picture a subject of copyright, has been used not to produce another picture, but to duplicate the original". This is a test which should have been applied.

The last time that the Supreme Court addressed the question of a test of copyright infringement was in *White-Smith Music Publishing Company v. Apollo Company*, 209 U.S. 1 (1907) where it quoted an earlier decision that "A copy is that which comes so near to the original as to give to every person seeing it the idea created by the original".

"The Cardinal" gives every person seeing it the idea created by "Cardinals on Apple Blossoms". Why isn't it an infringement?

The fact that the same artist did both works has confused this case and caused the lower Courts to reach the wrong conclusion. This same fact, however, makes the case a unique vehicle for setting out the appropriate test of copyright infringement and provide much needed direction to the lower Courts.

Franklin Mint's infringement has destroyed the credibility of National Wildlife in the marketplace and ruined its business. Why should anyone now buy a print limited in edition to 300 copies from National Wildlife, if Franklin Mint can closely duplicate that print and publish another 6000 copies of the same? The decisions below make a mockery of the copyright laws. They are a miscarriage of justice. Unless reversed, they will devastate the limited edition print business and will have far-reaching adverse effects on every single piece of copyrightable material.

The petition should be granted.

Respectfully submitted,

WILLIAM C. MCCOY, JR.
BOSWORTH, SESSIONS & MCCOY
625 National City Bank Building
Cleveland, Ohio 44114
(216) 781-9050
Counsel for Petitioners

Supreme Court, U. S.
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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1977

No. 77-1710

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and RALPH H. STEWART,

Petitioners,

v.

FRANKLIN MINT CORPORATION,

Respondent.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE
and
BRIEF AMICUS CURIAE OF
AMBASSADOR GRAPHIC ARTS, INC.
AMERICANA GRAPHICS, INCORPORATED
BAMA FINE ARTS
COTTAGE HILL WILDLIFE ART
FOXFIRE FINE ARTS
MASTERPIECE REPRODUCTION CO.
REALTECH ART, INC.
STEARNS & ASSOCIATES

ARTHUR J. LEVINE
1826 Jefferson Place, N.W.
Washington, D.C. 20036
(202) 785-0700
Attorney for Amicus Curiae.

Washington, D.C. • THIEL PRESS • (202) 638-4521

TABLE OF CONTENTS

Page

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE iii

ARGUMENT

I. The Purchaser of a Copyright is Entitled to Acquire Exclusive Rights 1

II. The Tests for Copyright Infringement 3

CONCLUSION 5

APPENDIX A – Article from *Forbes Magazine*, July 10, 1978: "Limited Edition Lithography: Buyer Beware!" 1a

TABLE OF AUTHORITIES

Cases:

Concord Fabrics, Inc. v. Marcus Brothers Textile Corp., 409 F.2d 1315 (2d Cir. 1969) 5

Gross v. Seligman, 212 Fed. 930 (2d Cir. 1969) 5

Key West Hand Print Fabrics, Inc. v. Serbin, Inc., 244 F. Supp. 287 (S.D. Fla. 1965) 5

Peter Pan Fabrics, Inc. v. Candy Frocks, Inc., 187 F. Supp. 334 (S.D.N.Y. 1960) 4

Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487 (1960) 4-5

Pushman v. New York Graphic Society, Inc., 287 N.Y. 302, 39 N.E.2d 249 (1942) 2

Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir. 1936) 4

Statutes:

17 U.S.C. §202 2

17 U.S.C. §204(a) 2

17 U.S.C. §301 2

Others:

Copyright Act of 1976 ..... 1, 2

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v.

FRANKLIN MINT CORPORATION,

Respondent.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

TO: The Honorable Chief Justice and Associate Justices of the Supreme Court of the United States

The aforementioned amici respectfully move for a leave to file the annexed Brief Amicus Curiae in support of the petition in the above captioned case for a writ of certiorari to the United States Court of Appeals for the Third Circuit. Consent to the filing of the annexed brief was sought from both parties through their attorneys of record. This motion is necessary because the respondents do not consent to the filing of the Brief Amicus Curiae.

This motion and the attached brief are submitted because the questions presented on the petition in this

case are of basic importance to the ability of the petitioner and of those in his like stead, amicus curiae in this case, to continue to remain in the business of selling limited edition fine art paintings. The issue is of import far transcending the specific interests of the parties to this litigation and one upon which the views of the amicus curiae herein may be of some assistance to this Court. An explanation of the business of limited edition print manufacturers and the pitfalls involved in such business are included in an article in FORBES MAGAZINE, July 10, 1978, a copy of which is attached to this Motion as Appendix A.

Because the effect of the decision below is to nullify the rights of those acquiring copyrights in fine art paintings and those who purchase prints believing them to be of limited edition, the amici are deeply concerned with the lower court ruling and submit this motion and the annexed brief to the end that the uncertainties and inequities generated by the ruling below may be promptly resolved.

Respectfully submitted,

AMBASSADOR GRAPHIC ARTS, INC.
1830 Savannah Highway
Box 30607
Charleston, South Carolina 29407

AMERICANA GRAPHICS, INC.
312 Gallatin Road South
Madison, Tennessee 37115

BAMA FINE ARTS
Route 5, Box 351
Prattville, Alabama 36067

COTTAGE HILL WILDLIFE ART
642 Parkside Avenue
Elmhurst, Illinois 60126

FOXFIRE FINE ARTS
2730 North Graham Street
Charlotte, North Carolina 28206

REALTECH ART, INC.
P.O. Box 15535
Chattanooga, Tennessee 37415

STEARNS & ASSOCIATES
P.O. Box 275
Stevensville, Maryland 21666

MASTERPIECE REPRODUCTION CO.
P.O. Box 926
Morganton, North Carolina 28655

By _____

ARTHUR J. LEVINE
1826 Jefferson Place, N.W.
Washington, D.C. 20036
(202) 785-0700
Attorney for Amicus Curiae.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1977

No. 77-1710

NATIONAL WILDLIFE ART EXCHANGE, INC.,
and RALPH H. STEWART,

Petitioners,

v.

FRANKLIN MINT CORPORATION,

Respondent.

BRIEF AMICUS CURIAE OF
AMBASSADOR GRAPHIC ARTS, INC.
AMERICANA GRAPHICS, INCORPORATED
BAMA FINE ARTS
COTTAGE HILL WILDLIFE ART
FOXFIRE FINE ARTS
MASTERPIECE REPRODUCTION CO.
REALTECH ART, INC.
STEARNS & ASSOCIATES
IN SUPPORT OF
THE PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

ARGUMENT

1. The Purchaser of a Copyright is Entitled to Acquire Exclusive Rights.

The intent of Congress, as expressed in the Copyright Act of 1976, effective January 1, 1978, is that the artist

or the author of any other copyrightable work can transfer his or her copyright in that work. Under the common law rule in effect in most states prior to January 1, 1978, an artist, merely by selling his painting, transferred all rights, both tangible and intangible, in that painting. *Pushman v. New York Graphic Society, Inc.*, 287 N.Y. 302, 39 N.E. 2d 249 (1942). In order to retain reproduction rights in the painting the artist was required to expressly so reserve them to him or herself. Congress, recognizing the essential unfairness of such a ruling, in enacting the Copyright Act of 1976, in effect, reversed the doctrine of *Pushman v. New York Graphic Society, Inc., supra.* Through the interaction of 17 U.S.C. §301, 17 U.S.C. §202, and 17 U.S.C. §204(a), an artist who sells a painting now merely sells the physical painting unless he or she transfers the intangible or literary property rights in the painting in a signed document of conveyance.

Under either the common rule of *Pushman, supra,* or the statutory scheme in the Copyright Act of 1976, the transferee of the intangible rights in a painting who has paid valuable consideration for those rights must be entitled to assume that he or she has acquired exclusive rights.

The effect of the ruling of the United States District Court for the Eastern District of Pennsylvania and the United States Court of Appeals for the Third Circuit is to make it impossible for a transferee to be certain of the extent of the rights acquired in a painting. If, as is the situation in the instant case, where Mr. Gilbert knew that he was selling his copyright, an artist transfers all of his rights, tangible and intangible, in a painting for valuable consideration and then produces a second painting which is, as characterized by the trial court, a "variation on a theme," then the transferee of the first painting has acquired an extremely limited right.

Amici herein, as is the petitioner, are small businesses. They derive their income by selling purchasers fine art print reproductions in limited editions. They warrant to their customers that only a limited number of prints of each work of art are to be sold. The assurance that only a relatively few prints are available to the public is relied on by the purchasers of the print. What assurances can companies in the business of selling limited art reproductions now provide their customers? If an artist such as Mr. Gilbert, who has received valuable consideration for selling exclusive rights in a painting, can paint a similar painting and then sell that painting to a third party, such as respondent Franklin Mint Corporation, who in turn publishes art reproductions, the purchaser of rights in the original painting has, in effect, acquired virtually no rights. The "variations on a theme test" leaves the purchaser of a copyright, and in particular the amici in the instant case, in a position of not being able to warrant to their customers that they are truly acquiring limited edition prints.

2. The Tests for Copyright Infringement.

The two essential elements of copyright infringement are present in the instant case. That Mr. Gilbert had access to the petitioner's work is a given in this case. Mr. Gilbert painted both "Cardinals on Apple Blossom" and "The Cardinal." It is on the second element of infringement, that of similarity, that the trial court and the Court of Appeals erred. Both courts relied heavily on the dissimilarities between the two paintings. The trial court, in its Findings of Fact, No. 51, listed some 10 differences between the two paintings. It relied heavily on the fact that "Cardinals on Apple Blossom" depicted a butterfly, but that "The Cardinal" did not.

> The absence of the large yellow butterfly in "The Cardinal" negates any striking similarity.

As a test of infringement, however, the fact that there exist differences between the two paintings is immaterial. Judge Learned Hand, in *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir. 1936), rejected defendant's argument that a motion picture did not infringe a play because there were dissimilarities between the two. In finding infringement he said:

> True, much of the picture owes nothing to the play; some of it is plainly drawn from the novel; but that is entirely immaterial; it is enough that substantial parts were lifted; *no plagiarist can excuse the wrong by showing how much of his work he did not pirate.* (Emphasis added.)

In considering the dissimilarities between the two paintings, the lower courts failed to consider the intent of Mr. Gilbert. Why did the artist leave out the butterfly in the second painting? Why does the new blossom in the second painting which replaced the butterfly look like a butterfly? Why did he juxtapose the position of the two cardinals? His intent may well be inferred from these negligible changes. Mr. Gilbert is an artist in the business of selling his paintings for reproduction in limited edition prints. In that he is unlike the artists Winslow Homer and Claude Monet cited in the lower court opinions. Mr. Gilbert and The Franklin Mint were well aware of the success of "Cardinals on Apple Blossom." In painting "The Cardinals" Mr. Gilbert attempted to create the same mood and expression of the first painting without creating an exact duplicate. The same principle "make it the same but different" has been attempted by textile fabric duplicators in copying designs, but with much less success in the courts than respondent has thus far enjoyed. *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F. Supp. 334 (S.D. N.Y. 1960); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (1960); *Concord Fabrics, Inc. v. Marcus Brothers Textile Corp.*, 409 F.2d 1315 (2nd Cir. 1969); *Key West Hand Print Fabrics, Inc. v. Serbin, Inc.*, 244 F.Supp. 287 (S.D. Fla. 1965).

CONCLUSION

Amici do not argue that an artist is forever precluded from treating in a second painting a subject he has previously painted. While it may be true that Monet repeatedly painted the same scene, the issue in this case is significantly different. The rule of *Gross v. Seligman*, 212 Fed. 930 (2d Cir. 1914), more nearly applies. Where an artist sells all rights in a painting to fine art reproducers and then in turn competes with those very same persons who have paid valuable consideration for the original painting, the courts must set limits which preclude the artist from, in effect, competing with those to whom he has sold his rights.

The lower court decisions not only seriously hinder the publisher of limited edition art reproductions but, of necessity, those decisions will also have a substantial deleterious effect on the artists whose works are reproduced. Without the assurance of exclusivity, amici and their like will undoubtedly be unwilling to pay substantial fees to artists who can in effect compete directly with the original purchaser of rights by selling a substantially similar painting to another publisher.

Respectfully submitted,

AMBASSADOR GRAPHIC ARTS, INC.
1830 Savannah Highway
Box 30607
Charleston, South Carolina 29407

(continued)

AMERICANA GRAPHICS, INC.
312 Gallatin Road South
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Route 5, Box 351
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Chattanooga, Tennessee 37415

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ARTHUR J. LEVINE
1826 Jefferson Place, N.W.
Washington, D.C. 20036
(202) 785-0700
Attorney for Amicus Curiae.

APPENDIX A

[Article from *Forbes Magazine*, July 10, 1978:
"Limited Edition Lithography:
Buyer Beware!"]

[continued]

Limited Edition Lithography: Buyer Beware!

The multiple images of printmaking and lithography are bringing good art to a wide audience. But they are also opening the door to phony investment pitches, deception and outright swindles.

By JAMES O'HANLON

AT THE TURN of the century when art expert Samuel Putnam Avery offered his big print collection to New York's Metropolitan Museum of Art, the trustees rang for the fellow who let Avery in. Art in those days was strictly for the carriage trade and only one-of-a-kinds counted—like paintings and sculpture. Back then a quality print by a 19th-century master that *today* might cost $50,000 sold for $25. Duplicate images off etching plates or lithographic stones just were not considered status art. As for Avery's prints, *they* eventually became the foundation for the New York Public Library's print collection—one of the world's largest.

Marilyn Multiplied: Andy Warhol shook up conventional notions of the artist's creative role when he began using photographic silk-screening techniques to reproduce "pop" images. A print from his "Marilyn" series—an edition of 3,000—first sold for $950 in 1968 and now costs $1,600.
Courtesy of All State Art, Inc.

Then came the revolution. The 1960s Americans, their taste raised by higher education and the mass media, began to discover that prints allowed an original Chagall, even an original Picasso, to be bought for a fraction of what a painting or a sculpture by the same artist would cost. Soon there were more Chagalls than Mercedes in New York City.

Stories began to spread about how much money could be made. An M.C. Escher engraving, for example, bought for $50 during the 1940s, when most people wouldn't have known a lithograph from a wallpaper sample, sold for 500 times that price during the early Seventies, when inflation was soaring and the whole world seemed like Argentina. Even last month an Escher woodblock print executed in 1939 called "Metamorphose" sold for $40,000.

Only a faint echo of the 1973 boom remains, but neophyte art buyers and profit-minded home decorators are being courted by a market segment of grubby, buyer-beware print discount stores, promise-them-anything art investment hustles and unethical sales practices. Worse, the greediness flourishes through consumer ignorance and a confusion of new printmaking techniques that border on photography.

Here is just a partial list of the many ways in which an innocent consumer can walk into a downtown poster emporium where "art" is stacked fifteen deep against the wall, or even into one of its baronial uptown counterparts, and walk out later with a whole lot less than he bargained for:

1) Many lithographs, silk-screen prints, etchings, *et al* are published in duplicate editions that the buyers, and sometimes even the salesmen, don't know about. For example, one edition of 100 lithographs may be printed on Arches paper and numbered, say, 1/100 or 23/100 in Roman numerals, while a second edition is printed on Japan paper and numbered in Arabic numerals. Sometimes the buyer isn't told that there's an American edition of 100, a European edition, perhaps a Japanese edition.

2) Forged signatures—or Who Signed That $1,000 Lithograph? Signed prints are usually more expensive than unsigned prints by the same artist. According to New York City Police Detective Robert Volpe, if an artist leaves an edition or part of an edition unsigned, there is a chance that someone will sign it for him.

3) Framed photoreproductions of prints (and even paintings) may be palmed off as authentic prints. (Lithographs are easier to fake this way than etchings, which leave an obvious impression in the paper.) Sometimes mass-produced posters are matted so that the lettering is blocked and sold as part of a limited edition. (A photo-offset reproduction of a print will always show neat lines of black dots under a magnifying glass. Every dealer should have one in his pocket.)

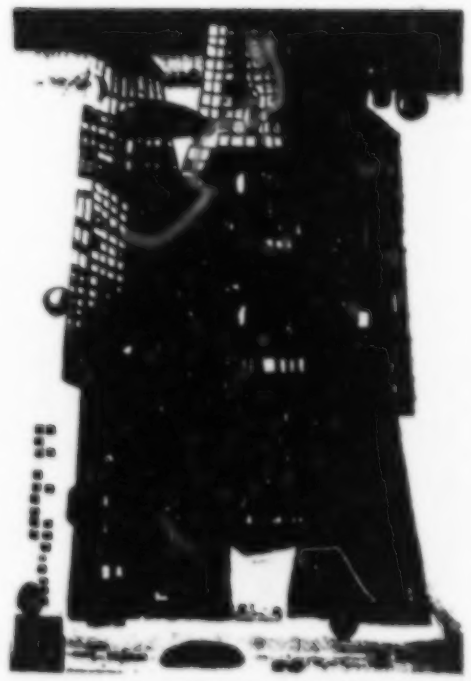
4) Extra prints may be run off at unsupervised printings and later sold as part of the edition or as artist's proofs.

5) Litho plates, stones, engraving plates and silk screens are often not destroyed after a limited edition is pulled, even though it is the concept of a limited edition that gives the value of rarity to a print. How many later copies came to market? That depends on the artist's ethics, the ethics of his heirs or consignors or conflicting concepts of an artist's responsibility to the art market.

2a

3a

Art For Status' Sake: Before the 1960s prints typically were made in editions of 50 to 100. Then came hordes of status seekers, and edition sizes soared. In 1969 Austrian artist Friedensreich Hundertwasser, who lives in the New Zealand bush, set a new standard, publishing his silk-screen print called "Good Morning City" in an edition of 10,000. The version at left was reproduced 8,000 times. The one on the right, 2,000. It took Hundertwasser three years to sign and number the combined edition. For each color used, a separate silk screen was cut. Value? Back in 1969 each of the 10,000 prints sold for under $100. Today, despite the large number around, they cost anywhere from $650 to $850.



Courtesy of Aberbach Fine Art

6) Many artists, including many esteemed "name" artists, do not make the silk screens, plates or stones from which their prints are made.

Imagine what is possible in the graphics supermarkets like the ones that flourish in New York City. Some of the salespeople who work in such places know little more about prints than do their uninitiated customers. The used-car business is pure ethics by comparison.

Some dealers coin gold out of what might be called an art sophistication gap. It is well known among print folk, for example, that the late Alexander Calder did not make most of the many lithographs bearing his signature that sell in almost any graphics gallery for prices up to $2,000. Says reputable art dealer Sylvan Cole Jr., "Calder dabbled in prints. In his later years he just turned over his drawings to other people."

But when FORBES asked the owner of a well-known Madison Avenue gallery in New York if the colorful Calder lithograph that he was selling for $750 was actually executed by the venerable master, the dealer replied, "It was done by the method that is considered to be typical of the artist." Meaning that Calder probably did a gouache drawing and turned it over to a printmaker.

And Calder was not the only well-known artist to have taken advantage of the opportunities in the expanding print market without doing much real printmaking. Salvador Dali, LeRoy Neiman, Marc Chagall and lately even Norman Rockwell, whose original oil paintings for *Saturday Evening Post* covers have been reproduced photomechanically, are just a few of the print-market "stars" who have signed their names to lithographs, etchings or silk screens made by technicians from the artists' original images.

When one New York gallery saleswoman was reminded that a certain popular artist probably hadn't made the silk-screen for the print that she was offering for $500, she flushed and pitched furiously, "You don't understand!"

Indeed, we barely do. We know that Andy Warhol is famous and rich from silk-screening photographs of Marilyn Monroe—and from the shoulders up, yet. And we know, too, that ultimately the fault for rip-offs lies with ourselves, the consumers. "To tell you the truth," says one gallery owner, "very few people who come in here even know enough about art to ask the right questions." As if to prove his point, he continues, "That lithograph on my wall that you were admiring is actually a picture of a Gustav Klimt painting that I ripped out of a magazine. I'm only selling it for the price of the frame. I just wish business was good enough so that I wouldn't have to do these things."

So it is not enough to ask the right questions, but it becomes important to ask them of somebody who will return the correct answers. After finding a print dealer with a reputation worth protecting (there are plenty around), ask these questions before you buy a print: When was this print edition published? How large was the edition? Any duplicate editions? ("It makes no difference how many editions are printed," says publisher Alex Rosenberg, head of New York-based Trans World Art, Inc., which publishes a few duplicate editions itself, "as long as the purchaser is privy to this information.") How many extra prints—artist's proofs—were made? What was the nature of the artist's involvement in the printmaking process? And, finally, did the artist or the publisher destroy or "cancel" (by scratching a line through an engraving plate, for example) the original stone, plate or silk screen after the limited edition was printed? Better yet, make sure your bill of sale includes all of the above information.

If the artist didn't destroy the plates, the same thing might happen to him as happened to Pablo Picasso. (He should live so long.) The prolific Picasso did a lithograph back in 1957 called "La Petite Corrida" (The Small Bullfight) in a limited edition of 50. But Picasso, like many artists of his day, didn't destroy the plate. Now a New York marketing outfit called The Metropolitan Gallery of Fine Art (*sic*), which contends that one of the original 50 Picasso prints is today worth "many thousands of dollars," is offering the same lithograph in a new edition of *8,000* for a mere $125 per print. What about the guy who may have recently paid "many thousands of dollars" for one of the original 50? Suddenly he's got one of 8,050. Yes, it might be argued, but his was signed by the great Picasso. How much is a Picasso autograph worth?

". . . Print salespeople continue to go out of their way to stress investment aspects of print buying despite estimates that 90% of art depreciates in value. . . "

We hate to say it, but you have to use almost as much caution in shopping for a lithograph as you do for a used car. Dealing and haggling is common and to be expected. Dealers usually buy new prints for 50% of the publisher's list price—so they have plenty of room to deal. Then, too, some dealers get better deals than others. "A publisher called me this morning with a new edition," says one dealer. "He offered the regular 50% discount, plus 40%." In other words, a print listed at $200 would be sold to one dealer for $100 and to another for $60. That means a careful print shopper could conceivably come across the same print selling for anywhere from $90 to $200—and in almost all cases the dealer would be making a nice margin. What does the artist get? Big names, of course, get better deals. But a young artist just getting started would be lucky to get 10% of the list price as part of his deal with the publisher.

So, what of the dream of making a killing in lithographs, as people sometimes do in one-of-a-kind art? It's almost impossible. Remember, in the first place, that 100% markup. Your print must double in value before you even make back the typical dealer's discount. (Where are the *customers'* yachts?) If it takes, say, ten years for the print to do that, you have made a fast 6% on your money. Unless you really like the print, you are better off in savings certificates.

In prints, moreover, the sky is rarely the limit. The highest price for a lithograph is $188,650 for an 1897 Toulouse-Lautrec sold in 1973 (one of 12 in that edition). A Picasso painting may go for $300,000 to over $1 million, while comparable Picasso lithographs cost between $15,000 and $180,000. Museum-quality prints of well-known artists sell for as little as $1,000; paintings by the same artists will cost at least ten times more.

But people can dream, can't they? "Almost everyone who comes in here asks about appreciation," says gallery owner Mitchell Sewall. Publisher Alex Rosenberg agrees: "People are more interested in the appreciation of art's monetary worth than in the quality of the art."

So, just as predictably, print salespeople continue to go out of their way to stress the questionable investment aspects of print buying—despite expert estimates that 90% of art sold depreciates in value rather quickly.

Consider, for example, an attractive young saleswoman in a midtown gallery who sizes up her prey, then blurts out: "Are you interested in art? I've got a very good investment for you." She goes on to describe a portfolio of 13 prints by 13 different artists in an edition of 200 sets, respectfully commissioned "in honor of Michelangelo's birthday." (Don't ask what she did for Michelangelo *last* year.) The price: something over $5,000 a set.

"Pure gimmickry," says one art expert. "That is as much of an investment as an Irish Sweepstakes ticket. Look, there are thousands of artists making prints today, and even the good ones are overproducing. Who knows which prints and which artists are going to make it to the top?"

So cool your jets, all you baby Rockefellers and high-rise de Medicis. Follow instead the advice of the cool-headed print curator at the Metropolitan Museum of Art, Colta Ives: "Don't buy art as an investment. Don't pay more for it than it is worth to you to have it hanging on your wall." ■

Fake: In his right hand, print dealer Sylvan Cole Jr. holds a photomechanical forgery of a Giorgio Morandi etching. The *real* Morandi in his left hand sells for $6,000.

Supreme Court, U. S.
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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1977 No. 77-1710

NATIONAL WILDLIFE ART EXCHANGE, INC., AND RALPH H. STEWART, *Petitioners*

v.

FRANKLIN MINT CORPORATION, *Respondent*

OBJECTION OF RESPONDENT TO MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

Arthur H. Seidel
Roberta L. Jacobs
SEIDEL, GONDA & GOLDHAMMER, P.C.
600 Three Penn Center Plaza
Philadelphia, Penna. 19102
(215) LO 8-8383
Counsel for Respondent

Of Counsel:
R. E. LaPorte
Franklin Mint Corporation
Franklin Center, Penna. 19091

THE LEGAL INTELLIGENCER, 66 NORTH JUNIPER STREET, PHILA., PA. 19107 (215) 561-4050

TABLE OF CONTENTS

	Page
I. Relevant Statutes	1
II. Argument—Reasons For Denying The Motion For Leave To File Brief Amicus Curiae	3
A. The Motion For Leave To File A Brief Amicus Curiae Should Be Denied For Failure To Comply With U. S. Supreme Court Rule 42-(3) ..	3
B. The Motion For Leave To File A Brief Amicus Curiae Should Be Denied Because The Interest Of The Proposed Amici, As Disclosed In The Motion, Is No More Than A Remote Interest	4
C. The Motion For Leave To File A Brief Amicus Curiae Should Be Denied As Untimely	5
III. Conclusion	5
Certificate Of Service	6

IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1977 No. 77-1710

National Wildlife Art Exchange, Inc.,
and Ralph H. Stewart, *Petitioners*,

v.

Franklin Mint Corporation, *Respondent*.

OBJECTION OF RESPONDENT TO MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

I. RELEVANT STATUTES

U.S. Sup. Ct. Rule 42, Briefs of an amicus curiae, provides:

> 1. A brief of an amicus curiae prior to consideration of the jurisdictional statement or of the petition for writ of certiorari, filed with the consent of the parties, or a motion for leave to file when consent is refused, may be filed only if submitted a reasonable time prior to the consideration of the jurisdictional statement or of the petition for writ of certiorari. Such motions are not favored. Distribution to the court under the applicable rules of the jurisdictional statement or of the petition for writ of certiorari, and its consideration thereof, will not be delayed pending the receipt of such brief or the filing of such motion.

2. A brief of an amicus curiae in cases before the court on the merits may be filed only after order of the court or when accompanied by written consent of all parties to the case and presented within the time allowed for the filing of the brief of the party supported.

3. When consent to the filing of a brief of an amicus curiae is refused by a party to the case, a motion for leave to file may timely be presented to the court. It shall concisely state the nature of the applicant's interest, set forth facts or questions of law that have not been, or reasons for believing that they will not adequately be, presented by the parties, and their relevancy to the disposition of the case; and it shall in no event exceed five printed pages in length. A party served with such motion may seasonably file an objection concisely stating the reasons for withholding consent.

II. ARGUMENT—REASONS FOR DENYING THE MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

A. The Motion For Leave To File A Brief Amicus Curiae Should Be Denied For Failure To Comply With U.S. Supreme Court Rule 42-(3)

U.S. Sup. Ct. Rule 42-(3) states that a motion for leave to file a brief amicus curiae shall set forth facts or questions of law that have not been, or reasons for believing that they will not adequately be, presented by the parties, and their relevancy to the disposition of the case.

Since, under U.S. Sup. Ct. Rule 42-(1) such motions are not favored, it is incumbent upon the moving party to clearly establish the need for a brief amicus curiae to be filed to bring new matter to the Court's attention.

The motion for leave to file brief amicus curiae filed on behalf of Ambassador Graphic Arts, Inc., Americana Graphics, Incorporated, Bama Fine Arts, Cottage Hill Wildlife Art, Foxfire Fine Arts, Masterpiece Reproduction Co., Realtech Art, Inc. and Stearns & Associates sets forth no facts or questions of law that cannot adequately be presented by the parties in any briefs on the merits which might be submitted. The motion does not set forth any reasons for believing that such facts or questions of law will not adequately be presented by the parties.

Review of the proposed brief amicus curiae submitted with the motion for leave to file the brief confirms that movant has, with respect to any relevant matters, done nothing more than raise questions of fact, including the question of credibility of testimony adduced at trial. These questions of fact have been repeatedly presented by the parties and properly answered by the United States District Court for the Eastern District of Pennsylvania and the United States Court of Appeals for the Third Circuit.

These questions of fact in the proposed brief are:

1. whether there is substantial similarity between the two works of art in issue;

2. whether a particular cluster of blossoms in one work of art resembles a butterfly in the other work of art; and

3. the artist's intent in creating the work alleged to infringe.

These questions of fact do not constitute such new matter as would be the proper subject of the brief of an amicus curiae.

B. The Motion For Leave To File A Brief Amicus Curiae Should Be Denied Because The Interest Of The Proposed Amici, As Disclosed In The Motion, Is No More Than A Remote Interest

The interest of the amici named in the motion is no more than a remote interest in the only issue actually involved in this litigation. This issue is whether a specific work of art entitled "The Cardinal" is a copy of and improperly appropriates the expression of a specific work of art entitled "Cardinals on Apple Blossom", notwithstanding the findings of fact of the two courts below (A 6, 10-13, 22, 31, 35).

The matters which the proposed amici seek to discuss in their brief, other than those questions of fact the parties have addressed and will undoubtedly address again if this Court requires, comprise, at most, issues collateral to the issue actually involved in the proceeding.

For the parties to be put in the position of having to respond to the proposed amici on such collateral issues would unnecessarily cause the briefs to be enlarged and would be likely to distract from the issue actually involved.

C. The Motion For Leave To File A Brief Amicus Curiae Should Be Denied As Untimely

U.S. Sup. Ct. Rule 42-(1) and -(3) state that a motion for leave to file a brief amicus curiae must be timely presented to the court.

The petition for a writ of certiorari of the party supported, petitioners National Wildlife Art Exchange, Inc. and Ralph H. Stewart, was due on May 15, 1978.

The motion for leave to file brief amicus curiae was not received by respondent until August 2, 1978. This motion manifestly has not been timely presented and therefore should not be granted.

III. CONCLUSION

For each and all of the foregoing reasons, the motion for leave to file a brief amicus curiae should be denied.

Respectfully submitted,

ARTHUR H. SEIDEL
Seidel, Gonda & Goldhammer, P.C.
600 Three Penn Center Plaza
Philadelphia, Penna. 19102
215—568-8383
Attorney for Respondent,
Franklin Mint Corporation

Of Counsel:
R. E. LaPorte
Franklin Mint Corporation
Franklin Center, Pa. 19091

CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of August 1978 three copies of the Objection Of Respondent To Motion For Leave To File Brief Amicus Curiae were served by first class mail on Arthur J. Levine, 1826 Jefferson Place, N.W., Washington, D.C. 20036, counsel for Ambassador Graphic Arts, Inc., Americana Graphics Incorporated, Bama Fine Arts, Cottage Hill Wildlife Art, Foxfire Fine Arts, Masterpiece Reproduction Co., Realtech Art, Inc. and Stearns & Associates; and three copies of the Objection Of Respondent To Motion For Leave To File Brief Amicus Curiae were served by first class mail on William C. McCoy, Jr., 625 National City Bank Building, Cleveland, Ohio 44114, counsel for petitioners.

I further certify that all parties required to be served have been served.

ARTHUR H. SEIDEL